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In the Supreme Court of the United States

OCTOBER TERM, 1970.

No. [redacted] 305

SKEGA AKTIEBOLAG
(formerly Skelleftea Gummifabriks A.-B.)
and
THE ALLEN PUMP CO.
(Trading as The Allen-Sherman-Hoff Pump Company),
Petitioners,

vs.

THE B. F. GOODRICH COMPANY,
Respondent.

PETITION FOR WRIT OF CERTIORARI
To the United States Court of Appeals
For the Sixth Circuit.

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Petitioners, Skega Aktiebolag (formerly Skelleftea Gummifabriks A.-B.) and The Allen Pump Co. (Trading as The Allen-Sherman-Hoff Pump Company), Appellants-Plaintiffs below, respectfully pray for issuance of a writ of certiorari to review the decision and judgment of the Court of Appeals for the Sixth Circuit entered on January 30, 1970, and a decision on rehearing entered on March 24, 1970, in the above entitled case.

I.

OPINIONS AND JUDGMENTS BELOW.

Opinion and judgment of the Sixth Circuit Court of Appeals, Appeal No. 19,292, entered January 30, 1970, the opinion being reported at 420 F.(2d) 1358 (A. 1-15).

Order of the Sixth Circuit Court of Appeals denying the Petition for Rehearing, entered on March 24, 1970 (A. 16).

Decision of the District Court for N.D.E.D. Ohio entered on November 18, 1968 (A. 16-25).

Judgment of the District Court for the N.D.E.D. Ohio entered on December 3, 1968 (A. 26).

II.

STATEMENT OF THE GROUNDS ON WHICH JURISDICTION OF THIS COURT IS INVOKED.

Review is sought of the decision of the Court of Appeals for the Sixth Circuit dated, and entered, on January 30, 1970. Jurisdiction to review by writ of certiorari is believed conferred by 28 U.S.C. 1254(1).

III.

QUESTIONS PRESENTED FOR REVIEW.

The Court of Appeals has decided a federal question of patent validity in a way which is in conflict with the statute and applicable decisions of this Court.

1. Were the directions of this Court for inquiries into the obviousness of the subject matter sought to be patented as set out in the cases of *Graham v. Deere*, 383 U.S. 1, 17, 18, and *Anderson's-Black Rock, Inc. v. Pavement Salvage Co.*, 396 U.S. 57, 305, understood by the Courts below or understandable by the Federal Courts generally? These directions were reiterated in the *Black Rock* case, at page 62 as follows:

> "Obviousness, as an issue, is resolved as follows:
>
> "Under § 103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved." (Citing *Graham v. Deere.*)

2. Did the Trial Court and the Court of Appeals below fail to understand and follow the requirements and method of analysis of this Court, *which are to be strictly observed*, as set forth in *Graham v. Deere*, 381 U.S. 1, 17; and *Anderson's-Black Rock, Inc. v. Pavement Salvage Co.*, 396 U.S. 57, in determining obviousness under 35 U.S.C. § 103?

3. Was it error for the Court of Appeals to treat the findings of the Trial Court as to obviousness as findings of fact and limit its scope of review to the "clearly erroneous" rule of Rule 52(a), Federal Rules of Civil Procedure contrary to the decision of this Court in *United States v. United States Gypsum Co.*, 333 U.S. 364, 395, and in conflict with *Payne Metal Enterprises, Ltd. v. McPhee*, 382

F.2d 541 (9 Cir. 1967) and *Tidewater Patent Development v. Kitchen*, 371 F.2d 1004 (4th Cir.)?

4. Are decisions below in conflict on the merits with the holding of this Court in *United States v. Adams*, 383 U.S. 39, with respect to the validity of the patent in suit?

IV.

CONSTITUTIONAL PROVISIONS, STATUTES AND RULES INVOLVED.

This case involves the commerce and patent clauses of the Constitution of the United States, Article I, Section 8 (A. 26), 28 U.S.C. 1254 (A. 27), 35 U.S.C. 101 (A. 27), 35 U.S.C. 102 (a and b) (A. 27), 35 U.S.C. 103 (A. 27-28), 35 U.S.C. 282 (A. 28) and Rules of the Supreme Court, Rule 19(1)(b) (A. 28), Rule 52(a) of the Federal Rules of Civil Procedure.

V.

STATEMENT OF THE CASE.

A. PROCEEDINGS IN THIS CASE.

On June 29, 1966, Petitioners-Plaintiffs instituted the present action against Respondent-Defendant for infringement of Svensson et al. U. S. patent in suit No. 3,107,867 [referred to herein as the Skega patent] which issued on October 22, 1963, for a wear lining for rotary grinders. Trial was held on June 17 to 26, 1968. The trial judge wrote no opinion and made only findings of fact and conclusions of law (A. 16-25).

Six of the Findings of Fact, Nos. 6-11, and Conclusions of Law Nos. 3, 6 and 9 dealt with the issue of infringement and found that the accused linings, Exhibits 61 and 62, embodied the invention of claims at issue, Nos. 1, 2 and 8 of the patent, and infringed said claims but denied Petitioners-Plaintiffs relief because of invalidity of those claims. Defendant-Respondent did not appeal. The only issue on appeal was that of validity of the claims in suit.

Findings of Fact, Nos. 12-30, and Conclusions of Law Nos. 4, 5 and 7 dealt with the issue of validity and held the claims in issue invalid for obviousness. Petitioners-Plaintiffs appealed from that holding of invalidity.

The Court of Appeals for the Sixth Circuit affirmed the District Court on the issue of invalidity for obviousness under 35 U.S.C. 103 (A. 1-15). A petition for rehearing was denied by the Court of Appeals for the Sixth Circuit on March 24, 1970 (A. 16).

B. BACKGROUND AND NATURE OF THE PATENT IN SUIT.

This case involves a situation much like that in *United States v. Adams*, 383 U.S. 39, with a history of problems and development in the field, and thus a proper understanding of the issues requires a review of the background of the field in which the art of the Skega patent is found. The relevant and material facts in the case are undisputed.

The Skega patent relates to rotary grinding mills, particularly ball mills, in which small solids are reduced in size by a grinding medium which consists of pebbles or steel balls. Ball mills have been in use for over one hundred years. In grinding low grade iron ore, for example, the small solids to be ground in a ball mill are less than about 1/6 of an inch in size. Such grinding is for the purpose of liberating the iron values from rock, quartz and like materials so that the iron values may be recovered.

A ball mill of the type here involved consists of a horizontal shell having a cylindrical midportion and walls at either end thereof, a lining for the inner surfaces of the shell and end walls, and means by which the shell is rotated. While the shell is rotating, the material to be ground is passed with water through an opening in one end wall and the ground material is discharged with the water through a screen in the other end wall. In passing through the mill, the material to be ground is subjected to the grinding action of the balls which, together with the material to be ground, is moved upwardly on the ascending side of the shell and then travels downwardly to the lower part of the shell.

Ball mills range from about 4 feet to as much as 45 feet in length and from about 3 feet to 19 feet or more in

diameter. A typical mill about 14 feet in length and about 10 feet in diameter has a charge consisting of about 70 tons of steel balls about 1½ inches in diameter, about 7 or 8 tons of iron ore and about 2 to 3 tons of water.

The early ball mills had steel linings. The first proposal to use rubber linings for ball mills was made in 1921. Since rubber possessed several properties which could be used to good advantage in a ball mill lining, the first proposal to make such linings was promptly seized upon by inventors, mining engineers and writers. Among the advantages visualized in the use of rubber lining over steel linings were the following: less weight and hence less load on the bearings, less volume and hence more space for the charge, less danger to workmen when installing or removing the linings, shorter time to install and replace the linings and hence less down time of the mill.

Between 1929 and 1963 four patents were issued representing efforts to design a successful rubber lining system for ball mills. These are the patents of Gammeter, Haushalter, Porteous and Skega. Drawings of these four patents are set forth opposite page 8, *infra*.

The Gammeter patent (1926), which was used by Respondent, The B. F. Goodrich Co., was not commercially successful because the rubber liner which was bonded to the mill shell tore off during use because of the forces at work in the mill.

The Haushalter patent (1933), which was developed by an employee of the Respondent, used liner plates of rubber clamped longitudinally to the inside of the mill shell by metal clamps. This design was successful to the extent that it kept the longitudinal slabs of the liner in place with a metal clamp. However, the metal clamp wore out quickly by the abrasive action of the charge so

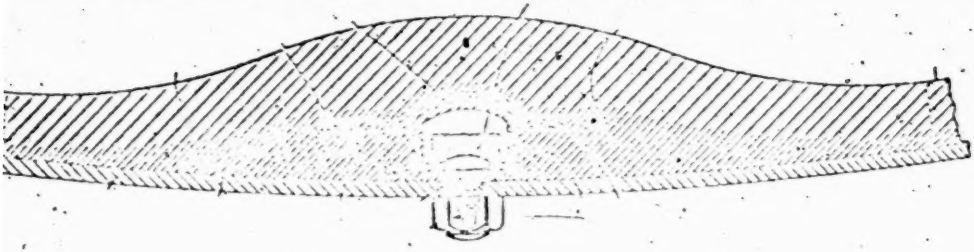
that the benefits of a complete rubber lining were not achieved.

The Porteous patent (1936) used a metal bar to hold the rubber liner plates against the mill shell and covered the inner sides of the bar with a slab of rubber. This slab was vulcanized to the bar. *The Porteous lining failed to pass its first experimental test.* The apparent reason for this failure was that the vulcanized joint between the rubber cover and the metal bar broke under the impact forces of the charge and the rubber cover would not stay in place.

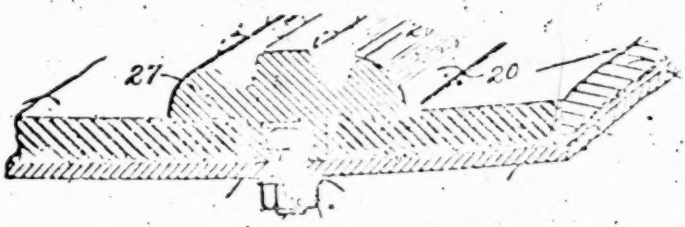
Defendant tried, in vain, to make a satisfactory rubber lining for a ball mill beginning in 1924 and ending with abandonment in 1940. Many people, including inventors, engineers and highly skilled people, tried to make a satisfactory rubber lining from 1924 to about 1960. All failed because the rubber could not be maintained in the ball mill for the full wear life of the rubber.

The next patent in the field is the Skega patent (1961). It solved the problem left by the exposed steel clamp and permitted for the first time the use of a complete system of rubber liners for ball mills. The Skega lining involved a principle of operation entirely new to the art and a new structure to carry out the new principle. That structure involved a new "lifting means" that consisted of a large chunk of rubber placed longitudinally in the mill, fitting over the edges of the liner plates with a longitudinally extending, laterally projecting internal slot, into which was inserted a metal bar which was then bolted to the mill shell. The bar engaged the lifter and pressed it against the liner plates. Thus, the large rubber "lifter" and the liner plates were held in place by positive clamping action as distinguishd from the vulcanized joint used in Porteous. Immediately after the Skega construction

Gammeter Patent No. 1,601,956, Oct. 5, 1926.



Haushalter Patent No. 1,921,672, Aug. 8, 1933.



Porteous Patent No. 2,058,257, Oct. 20, 1936.

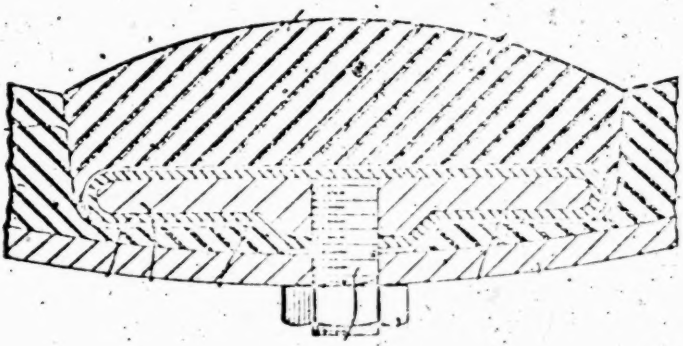
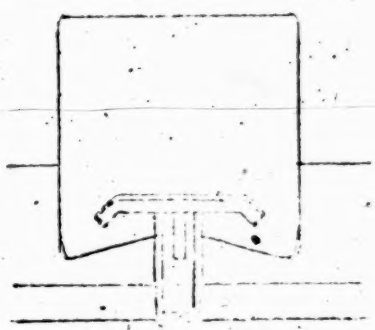


Fig. C-C of Ex. 63, Skega Brochure of August, 1963.



was publicized, Respondent adopted it, hence this patent infringement suit.

Entirely unrelated to and, prior to this lawsuit, unconnected with the art of rubber linings for ball mills, there existed two patents used for clamping solid rubber tires to the rims of turn of the century bicycle and truck wheels. The first of these was Straus, issued in 1891, and the second was Overman, issued in 1914. Drawings of these two patents are shown in the Appendix to the Opinion of the Court of Appeals (A. 12 and 13) hereof. The trial court held that Skega had done no more than make a new use of the clamping means of Straus and Overman (Conclusion of Law No. 5); and that it was obvious to use those clamping means in a rubber lining for a ball mill. (Conclusion of Law No. 4.)

C. THE PATENT MEETS SEVERAL STATUTORY REQUIREMENTS FOR VALIDITY.

The Courts below, by their silence, apparently accepted Petitioner's contentions that the patent in suit met the following requirements for validity:

Presumption of Validity.

The patent in suit is presumptively valid.

35 U.S.C. 282.

The burden of proof was on Respondent and was a heavy one.

Mumm v. Decker, 301 U.S. 168, 171;
Radio v. Radio, 293 U.S. 1, 7.

The presumption of validity was greatly strengthened by the facts that the best prior art was cited by the

Examiner, that Respondent relied on that prior art and that Respondent infringed the patent.

Florence Mayo Nuway Co. v. Hardy, 168 F.(2d) 778, 782 (CA 4);

Cold Metal Process Co. v. Republic, 233 F.(2d) 828, 837 (CA 6).

Utility and Novelty.

The statutory requirements of *utility*, 35 U.S.C. 101, and *novelty*, 35 U.S.C. 102 (a & b) have been admitted or not contested.

The only remaining statutory requirement for validity to be considered is *non-obvious subject matter*, 35 U.S.C. 103.

VI.

REASONS FOR ALLOWANCE OF THE WRIT.

1. THE BASIC INQUIRIES WITH RESPECT TO OBVIOUSNESS LAID DOWN IN GRAHAM v. DEERE.

This Court in *Graham* in 1966 for the first time construed § 103 (which was added to the law in 1952). The Court stated, 383 U.S. 1 at p. 17:

> "While the ultimate question of patent validity is one of law, *A. & P. Tea Co. v. Supermarket Corp.*, *supra*, at 155, the § 103 condition, which is but one of three conditions, each of which must be satisfied, lends itself to several basic factual inquiries. *Under § 103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background, the obviousness or nonobviousness of the subject matter is determined.*" (Emphasis added.)

In the *Black Rock* case, in referring to those requirements, this Court said:

> **"We admonished that 'strict observance' of those requirements is necessary."** (Emphasis added.)

Between the date of *Graham* (1966) and the first of May 1970 many lower Courts have handed down decisions in which words have been copied from the *Graham* decision. We have examined many of those decisions and have found that in none of them has any Court shown an understanding of what the copied words actually mean or were intended to mean. More particularly, no decisions have defined the "factual inquiries" of "the differences between the prior art and the claims in suit" or "the level of ordinary skill" in the art.

We believe that *Black Rock* and the present case are symptomatic of a difficulty which trial and appeals courts are having applying the *Graham* ease and indicate that those need further assistance from this Court in making the required factual inquiries.

In the present case the trial court seems to have attempted to follow the statutory requirements of *Graham* and Sixth Circuit approved of the Finding. But, as we will show in the next section, the results of the trial court's efforts, as affirmed, fall so completely short of, and are so much in conflict with, statutory requirement and any reasonable interpretation of this Court's direction in *Graham*, both as to the quality and depth of analysis in the findings and conclusions, that it suggests the probability that neither the trial court nor the court of appeals understood what this Court was seeking to achieve by its directions. Moreover, the failure of the courts below to follow the requirements of *Graham* has led to a result that we believe is plainly and palpably in error in the result that should

have been controlled by *United States v. Adams*, 383 U.S. 39.

Clearly it is of vital importance to the patent law that 35 U.S.C. § 103 as construed in *Graham* be understood by the lower courts so that uniformity and certainty of result will be achieved. If, as we believe, this Court's directions as to the basic factual inquiries are not properly understood by the lower courts, the patent law is presented with a problem of truly major proportions as the issue is present in almost every case involving patentability.

2. THE FINDINGS IN THIS CASE DO NOT MEET THE REQUIREMENTS OF GRAHAM v. DEERE.

The bases of the trial court's decision are found in Conclusions of Law Nos. 4 and 5 as follows:

> "4. Claims 1, 2 and 8 of the patent in suit are invalid under 35 U.S.C. 103 because the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been, and it was in fact, obvious at the time the invention was made to persons having ordinary skill in the pertinent art.
>
> 5. The alleged invention of the patent in suit is invalid for comprising no more than a new use for the clamping means disclosed in Straus patent No. 449,502 and in the Overman patent No. 1,092,078 with merely the natural consequences thereof."

Since the court treated the case as a combination of prior art, viz.: the rubber ball mill art and the tire art of Straus and Overman, the court, under *Graham v. Deere*, had to make the required findings as to both arts and the obviousness of combining them.

(a) The Prior Rubber Lined Ball Mill Art.

The pertinent prior art in the rubber lined ball mill field was properly found in the sense that the prior art patents were placed in the record before the Court and were mentioned by it in the Findings. These consisted principally of the following patents: Gammeter, Haushalter and Porteous. Diagrams of these and the patent in suit are set forth opposite page 8 of this Petition. Of these, Porteous was the last and best of the prior art.

The Findings with respect to the ball mill art are Nos. 12, 13, 14, 15, 16, 17, 21, 29 and 30. Of these, Nos. 13, 14, 15, 16, 17 and 21 are simply descriptive of the several patents which were generally agreed on by all parties and, which as to the core issue involved, are merely neutral background material. The same is true of the first sentence of Finding 12. Findings 29 and 30 and the last sentence of Finding 12 are simply conclusions, really conclusions of law.

None of these findings touch on the prior art as related to the central issue in this case, viz., the failure of the prior designs to retain a rubber lining during its full wear life and the reasons therefor, or more precisely, the prior art with respect to clamping the liner plates in while at the same time providing a clamping device such as would successfully present a rubber surface toward the center of the mill for an extended period of use. We believe these findings fail utterly to carry out the substantive requirements of *Graham v. Deere*.

(b) The Content of the Prior Tire Art.

This point is covered in Findings 18, 19 and 20. Finding 18 is a conclusion. No. 20 simply describes the Straus and Overman Patents. Finding 19 is in part factual and perhaps relevant to the pertinency of that art. Combined,

these "Findings" are entirely too meager to meet the substantive requirements of *Graham v. Deere*.

(c) The Differences Between the Prior Ball Mill Art and the Skega Patent.

There is one finding on this point, No. 27. It is factually accurate as far as it goes, but fails entirely to state the significance of the differences in structure mentioned and fails to set forth all the structural differences as well as any of the differences in function, operation and result between Porteous and Skega that are set forth in the Record. This finding surely fails to meet the substantive requirement of *Graham v. Deere*. Pertinent to the substantive requirements embraced in the required findings are the holdings of this Court in *Machine Co. v. Murphy*, 97 U.S. 120 and *Bates v. Coe*, 98 U.S. 31, when the Court stated at page 42:

> "Devices in one machine may be called by the same name as those contained in another, and yet they may be quite unlike in the sense of the patent law, in a case where those in one of the machines perform different functions from those in the other. In determining about similarities and differences, courts of justice are not governed merely by the names of things but they look at the machines and their devices in the light of what they do, or what office or function they perform, and how they perform it, and find that a thing is substantially the same as another, if it performs substantially the same function or office in substantially the same way to obtain substantially the same result; and that devices are substantially different when they perform different duties in a substantially different way, or produce substantially a different result. Calicon v. Ring, 1 Cliff. 620."

(d) The Differences Between Skega and the Rubber Tire Art.

The relationship of Straus and Overman—the turn of the century rubber tire art—to Skega is crucial since the Skega patent was held invalid by the Trial Court solely on the basis of combining that art with the ball mill art. Even so, the only finding (Finding 28), as to differences between Skega and the tire art is that "The difference lies primarily in the use intended for each structure." Considering the totally different settings, structures, functions, purposes, etc., involved between a ball mill and a solid rubber tire, this finding of differences hardly seems to meet the substantive requirements of *Graham v. Deere*.

(e) Level of Ordinary Skill in the Pertinent Art at the Time of the Invention.

The Trial Court reduced the Skega invention to a combination of the rubber ball mill art taught by Porteous with the teaching of Straus and Overman with respect to the method of clamping solid rubber tires to their wheels. We frankly feel that the structure, operation and function of rubber lined ball mills is so distant from that of the old solid rubber tires that the latter is not pertinent or analogous to the former. Nevertheless, assuming there is some reasonable connection between them, the question becomes whether the combination was obvious to one of ordinary skill of the "pertinent" art at the time of the invention, which presumably in a case such as this would be both arts. *United States v. Adams*, 383 U.S. 39.

Under the rules laid down in *Graham v. Deere*, the third inquiry deals with this problem. The Trial Court was required to ascertain the level of ordinary skill in the pertinent art (or arts), and under 35 U.S.C. this must be

found as of the time of the invention. Findings 22, 23, 24, 25, and 26 which is simply a conclusion, deal with this requirement. The sole evidence on which Findings 22 through 25 are based is the testimony of Phillip F. Allen. They merely repeat Mr. Allen's statements that the Skega design was obvious to him in 1964, some 2½ years after the Skega invention was made. Mr. Allen specifically admitted, however, that the Skega lining was not obvious to him in 1963. Therefore, it could not have been obvious to him at the time of the Skega invention in 1961.

Thus, the only findings made by the Trial Court on the critical question of the level of ordinary skill in the pertinent arts at the time the Skega invention was made was based on testimony about Mr. Allen's thoughts as to what only became "obvious" to him some three years after the invention was made! This is in direct violation of 35 U.S.C. § 103 and *Graham v. Deere*. With this evidence eliminated, there are simply no findings at all on the critical inquiry as to the level of ordinary skill.

The Record in the case actually is replete with evidence on the level of invention in 1961. For over 40 years, at least 20 experts in the field attempted to solve the very problem solved by the Skega patent. Many of them were working for the Respondent, The B. F. Goodrich Co. If ever there was an expert in both of the arts in question, viz. the rubber lined ball mill art and the rubber tire art, it was the Respondent. The Record, therefore, clearly discloses that one of the world's greatest experts in both of the arts in question had its top experts working on the precise problem in question, and for 40 years they failed totally to solve the problem—to combine the ball mill and rubber tire arts (assuming the latter to be pertinent to the former). Yet when the Skega patent was publicized, Respondent promptly seized on it and started using it.

Findings Nos. 7, 8, 9, 10, 11. Thus the combination of arts in question was in fact not obvious to the greatest experts in the world in 1961; *a fortiori*, the level of ordinary skill in the art did not comprehend this combination. Throughout this litigation, Respondent has totally failed to explain why the alleged combination of arts was obvious to a person of ordinary skill but not to The B. F. Goodrich Co., inventors and engineers in both fields, particularly when it was attempting, through a 40 year period, to do what Skega did: develop a satisfactory rubber lining for ball mills.

In any event, since the only findings on the point were based on incompetent evidence, no valid findings at all exist on this critical and decisive inquiry in clear violation of *Graham v. Deere* and 35 U.S.C. § 103.

If the testimony of Mr. Allen had related to a period prior to the Skega invention, the question would remain as to whether what he considered as "obvious" *to him* can be used to determine the level of ordinary skill in the art since he was in fact an expert in the field.

Inventors, engineers and others highly skilled in the art are generally classified above skilled mechanics and those of ordinary skill. *Marvel Specialty Co. v. Bell Hosiery Mills Co.*, 330 F. (2d) 164, 171 (CA 4); *Baldwin-Lima-Hamilton Corp. v. Tatnall Measuring Systems Co.*, 169 F. Supp. 1, 17 (DCPa.) Affd. 268 F. (2d) 395.

What we think this Court meant by this "level" inquiry was that the courts should consider all the evidence of record as to what people of various degrees of skill had attempted to do, had failed to do and had succeeded in doing. Evaluation of that evidence would remove all guesswork from a decision on the issue of whether the patentee had done more than one of ordinary skill would have done.

3. THE COURT OF APPEALS BELOW INCORRECTLY USED AS THE SCOPE OF ITS REVIEW ON THE QUESTION OF OBVIOUSNESS RULE 52(a) OF THE FEDERAL RULES OF CIVIL PROCEDURE.

The proper standard or scope of appellant review is always a vital question in the law. The problem here raised relates to review of (a) the findings under the basic inquiries of *Graham v. Deere*, and (b) the ultimate determination of obviousness under 35 U.S.C. sec. 103.

The court of appeals stated:

> "The District Court held that this combination of separate rubber lifting means and separate lining plates disposed between and held in the drum by the lifting means, was well within the scope of the prior art. Examination of the prior patents in the art of grinding mill linings indicates that this finding *is not clearly erroneous.*" (Emphasis added.)

* * * * *

> "The District Court not only found that every element of the Svensson patent was old and within the scope of the prior art, but also that it was obvious at the time the invention was made to persons having ordinary skill in the art of clamping rubber to metal. 35 USC sec. 103 (1952). In so crediting the testimony of the Appellee's experts we cannot say that the District Court erred in fact or law. Rule 52 (a), Federal Rules of Civil Procedure."

We believe this was error. Rule 52 (a) of F.R.C.P. provides:

> "(a) Effect. In all actions tried upon the facts without a jury or with an advisory jury, the court shall find the facts specially and state separately its conclusions of law thereon, and judgment shall be entered pursuant to Rule 58;

* * * * *

"Findings of fact shall not be set aside unless clearly erroneous, and due regard shall be given to the opportunity of the trial court to judge the credibility of the witnesses. * * *"

The finding of the basic inquiries are not of the kind or quality of those contemplated by Rule 52(a). In the present case the facts were not in dispute; the findings are descriptive and conclusionary. See, for example, Findings Nos. 18, 19 (first sentence), 24, 25, 26, 29 and 30.

The decision of the Sixth Circuit is in conflict with the Ninth and Fourth circuits in *Payne Metal Enterprises, Ltd. v. McPhee*, 382 F.2d 541 (9th Cir. 1967). The court stated on page 543:

"Appellees McPhee and Anchor contend that since the trial court made factual findings to the effect that McPhee No. 986 would not have been obvious to a person ordinarily skilled in the art, this court cannot reject these findings unless they are 'clearly erroneous' under Rule 52 (a), Federal Rules of Civil Procedure.

|2| We do not agree. This court has recently stated that '|t|he obviousness or nonobviousness of the subject matter of a patent presents a question of law.' Hensley Equipment Company, Inc. v. Esco Corporation, 9 Cir., 375 F.2d 432, 436. Therefore, although the trial court labeled its determination as to the obviousness of the McPhee No. '986 as a finding of fact, for purposes for review in this court it is still considered a question of law, not subject to the limitations on review set forth in Rule 52 (a), Federal Rules of Civil Procedure."

In *Tidewater Patent Development v. Kitchen*, 371 F. 2d 1006 (4 Cir. 19) at page 1006 the court stated:

"As the criteria governing patentability are standards of law, and since the decision of the District

> Court was largely based on documentary evidence, in not following the conclusions of the trial court we are not offending the 'clearly erroneous' precept of Rule 52 (a) F. R. Civ. P. (citing decisions)."

We believe it is of greatest importance that the conflict between the Sixth Circuit and the Fourth and Ninth Circuits be resolved by this Court by reversing the court below.

4. THE SKEGA PATENT SHOULD BE SUSTAINED.

The Skega patent, by a structure entirely new to the rubber linings for ball mills successfully solved a problem that despite intense research efforts by Respondent, the B. F. Goodrich Co. and others had prevented the use of rubber liners in ball mills for 40 years. The result was novel; it was inventive. Even if the rubber clamping method of solid rubber tires of the turn of the century is, in the abstract, somewhat like the clamping principle used by Skega, its use in ball mills was an act of invention since the context, the structures, the problems and the mode of operation are entirely different from clamping solid tires for bicycles. In any event, combining the two was inventive and non-obvious. It was never obvious to the B. F. Goodrich Co., the expert in both fields.

That the Skega construction was inventive is clearly controlled by *United States v. Adams*, 383 U.S. 39, where the court stated at pages 48, 50:

> "The Government concludes that wet batteries comprising a zinc anode and silver chloride cathode are old in the art; and that the prior art shows that magnesium may be substituted for zinc and cuprous chloride for silver chloride. Hence, it argues that the 'combination of magnesium and cuprous chloride in the Adams battery was not patentable because it

represented either no change or an insignificant change as compared to prior battery designs.' And, despite 'the fact that, wholly unexpectedly, the battery showed certain valuable operating advantages over other batteries (these advantages) would certainly not justify a patent on the essentially old formula.'

* * * * *

Here, however, the Adams battery is shown to embrace elements having an interdependent functional relationship. It begs the question, and overlooks the holding of the Commissioner and the Court of Claims, to state merely that magnesium and cuprous chloride were individually known battery components. If such a combination is novel, the issue is whether bringing them together as taught by Adams was obvious in the light of the prior art."

The Court went on to hold that the combination of known elements in the Adams patent was inventive and nonobvious. If the combination of known elements in the primary art can be inventive as in Adams, a combination of totally unrelated arts is *a fortiori* inventive.

VII.

SUMMARY AND CONCLUSION.

It is strongly urged that this Court should explain its meaning of the basic factual inquiries and the requirements which should be strictly observed, all as stated in the *Graham* and *Black Rock* cases. Only in this manner can the Lower Courts come to understand and comply with those directions and requirements and only in this way can progress be made toward uniformity and certainty of decisions of patent validity. If this petition is denied, the present uncertainty of the Lower Courts will

persist and the progress made toward uniformity and certainty by the *Graham* decision will be largely dissipated, and the same will be true of the scope of appellate review.

Petitioners respectfully request that this petition for a writ of certiorari be granted.

Respectfully submitted,

B. D. WATTS,
H. F. SCHNEIDER,
Attorneys for Petitioners.

Of Counsel:

THOMAS S. WEARY,
JOHN C. DORFMAN,

Dated: June 19, 1970.

APPENDIX

APPENDIX I.

OPINION OF THE UNITED STATES COURT OF APPEALS FOR THE SIXTH CIRCUIT.

(Filed January 30, 1970.)

Before: PHILLIPS, Chief Judge, EDWARDS and CELEBREZZE, Circuit Judges.

CELEBREZZE, Circuit Judge. Skega Aktiebolag and its licensee, the Allen Pump Company [hereinafter "Appellants"], filed this action in the United States District Court for the Northern District of Ohio, Eastern Division, complaining that the B. F. Goodrich Company [hereinafter "Appellee"] had infringed the Appellants' patent on a lining for a rotary ball mill. The Appellee counterclaimed for a declaration that the patent was invalid. 35 U.S.C. § 103 (1952). After a trial, the District Court entered judgment for the Appellee.

Rotary ball mills, which are principally used for grinding ore, are slowly rotating horizontal cylinders about half full of a "charge" of hard rock balls or steel balls mixed with ore. As the ball mill rotates the charge is lifted or carried up the ascending side of the cylinder by friction between the charge and the lining, by the centrifugal force generated by the rotation, and, to some extent, by projections on the surface of the lining known as "lifting means." At the point where the force of gravity on the charge exceeds the forces described above the charge tumbles back down over itself. This tumbling action produces collisions between the hard balls and the ore, resulting in the pulverization of the ore. As the mill rotates, unground ore is fed in through one end of the cylinder, and the ground ore is discharged through a mesh or grate in the other end. Because of the intense friction on the walls of the mill, it is essential that the cylinder,

i.e., the ball mill shell, have a lining which can be replaced when worn out.

The patent in suit, No. 3,107,867 [hereinafter "Svensson" patent], is on a rubber wear lining for a rotary ball mill. The patent makes eleven claims, three of which the Appellants charged were infringed by the Appellee's lining.[1] Translated, these claims describe a rubber wear lining composed of two kinds of alternating rubber slabs, called lifting means and lining plates. [*See* Appendix 1.] The lifting means have internal slots in which metal bars are inserted. Bolts from the metal bars to the ball mill shell not only secure the lifting means, but the pressure exerted on the longitudinal edges of the lining plates by the bar, bolt, and lifting means also holds the lining plates firmly to the wall of the drum.

The District Court held that this combination of separate rubber lifting means and separate lining plates disposed between and held in the drum by the lifting means, was well within the scope of the prior art. Examination of the prior patents in the art of grinding mill linings

---

[1] "What we claim is:

1. Wear lining of rubber for rotary drums, comprising a plurality of adjacent sections of separate rubber lifting means and separate rubber lining plates disposed between the said lifting means, the said lifting means being provided with an internal slot having bars inserted therein, said bars having threaded pins welded thereon for holding the lifting means.

2. Wear lining of rubber for rotary drums, comprising a plurality of adjacent sections of separate rubber lifting means and separate rubber lining plates disposed between the said lifting means, the said lifting means being provided with an internal slot wherein bars having threaded holes are inserted for holding the lifting means.

* * *

8. Wear lining according to claim 7, and in which the rubber lining plates are held to the wall of the drum by a pressure exerted by the lifting means on the bottom walls of the recesses in the longitudinal edges of the rubber lining plates.

* * * *"

indicates that this finding is not clearly erroneous. The Porteous patent, No. 2,058,057 [Appendix 2], comprised the same features and used identical retaining means, *i.e.*, lining plates disposed between and held in place along their longitudinal edges by rubber-coated metal bars homologous to the Svensson lifting means. The Haushalter patent, No. 1,921,672 [Appendix 3], contained the same features and employed virtually identical retaining means, except in Haushalter the lifting means were metal. In Lawler, No. 1,315,025 [Appendix 4], and Read, No. 1,986,530 [Appendix 5], virtually the identical combinations were present, however, the analogues of the Svensson lifting means and lining plates were made entirely of metal rather than rubber.

We find no merit in the Appellants' contention that the art of securing rubber tires to metal rims is not analogous to the art of securing lifting means to ball mill shells. The test for analogous arts is similarity of elements, problems, and purposes.

> "To ascertain whether two arts are analogous, heed must be given not merely to their physical differences but particularly to the differences in their problems and the means and methods of solving them." *Baldwin-Lima-Hamilton v. Tatnall Measuring Systems Co.*, 169 F. Supp. 1, 14, *rev'd on other grounds*, 268 F.2d 391 (3d Cir. 1959).

The District Court found that both arts employ similar means and elements to clamp rubber to metal:

> "The stresses, forces and loads per unit area tending to abrade, wear and detach such tires from their rims are of the same, or substantially the same nature and kind and of similar or greater magnitude than those to which such lifters are subjected in the drums of ball mills."

The District Court properly found that if Svensson's use of the metal clamping bar to hold the lifting means in place was novel at all, in light of the prior Porteous patent, it was merely a new use for a clamping means (originally employed on bicycle tires) that was 70 years old at the time this patent was granted. *See* Strauss patent, No. 449,502 [Appendix 6], and Overman patent, No. 1,092,078 [Appendix 7].

The District Court not only found that every element of the Svensson patent was old and within the scope of the prior art, but also that it was obvious at the time the invention was made to persons having ordinary skill in the art of clamping rubber to metal. 35 U.S.C. § 103 (1952). In so crediting the testimony of the Appellee's experts we cannot say that the District Court erred in fact or law. Rule 52(a), Federal Rules of Civil Procedure.

The Appellants protest that theirs is the first commercially successful rubber ball mill lining. However, commercial success is not proof of patent validity. *See Graham v. John Deere Co.*, 383 U.S. 1, 17 (1966); *Anderson's Black Rock, Inc. v. Pavement Salvage Co.*, 38 U.S.L.W. 4024 (U.S.S.Ct., Dec. 8, 1969).

> "Commercial success is a relevant consideration only in a close case; it does not by itself establish the validity of a patent." *Kaiser Industries Corp. v. McLouth Steel Corp.*, 400 F.2d 36, 42 (6th Cir. 1968).

The judgment of the District Court is affirmed.

Appendix 1

Oct. 22, 1963 A. N. SVENSSON ET AL 3,107,867

WEAR LINING

Filed Feb. 23, 1962 2 Sheets-Sheet 1

FIG. 3

FIGURES 3, 4 OF THE PATENT IN SUIT

(drawn to the same scale)

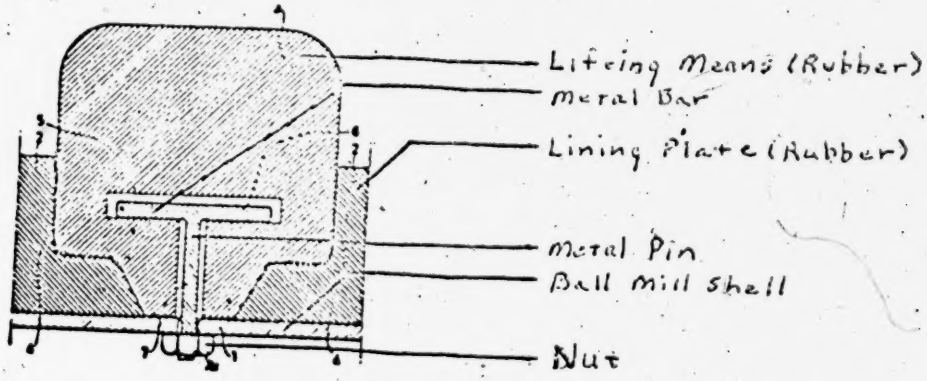
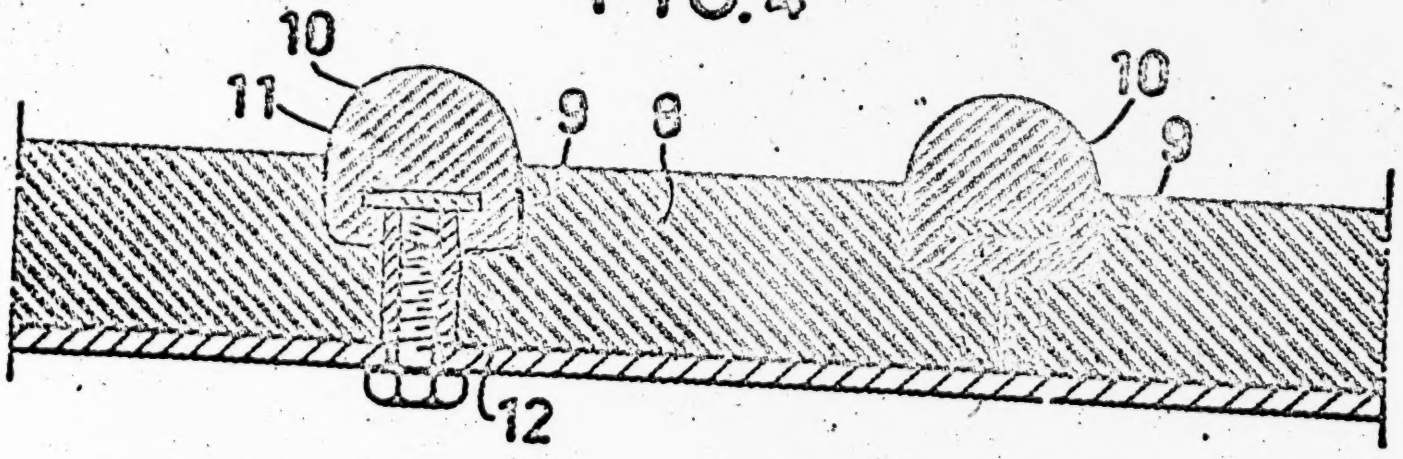


FIG. 4



A5

Appendix 2

Oct. 20, 1936. J. A. PORTEOUS 2,058,257

RETAINING MEANS FOR RUBBER LININGS

Filed April 27, 1935

Fig. 1.

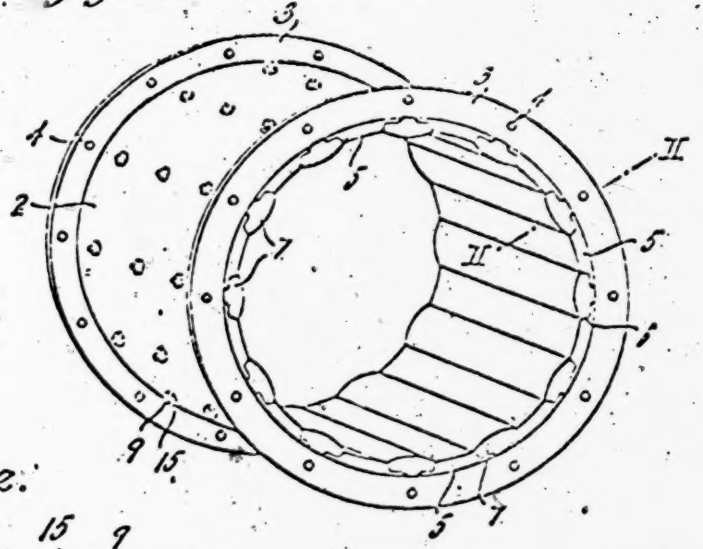
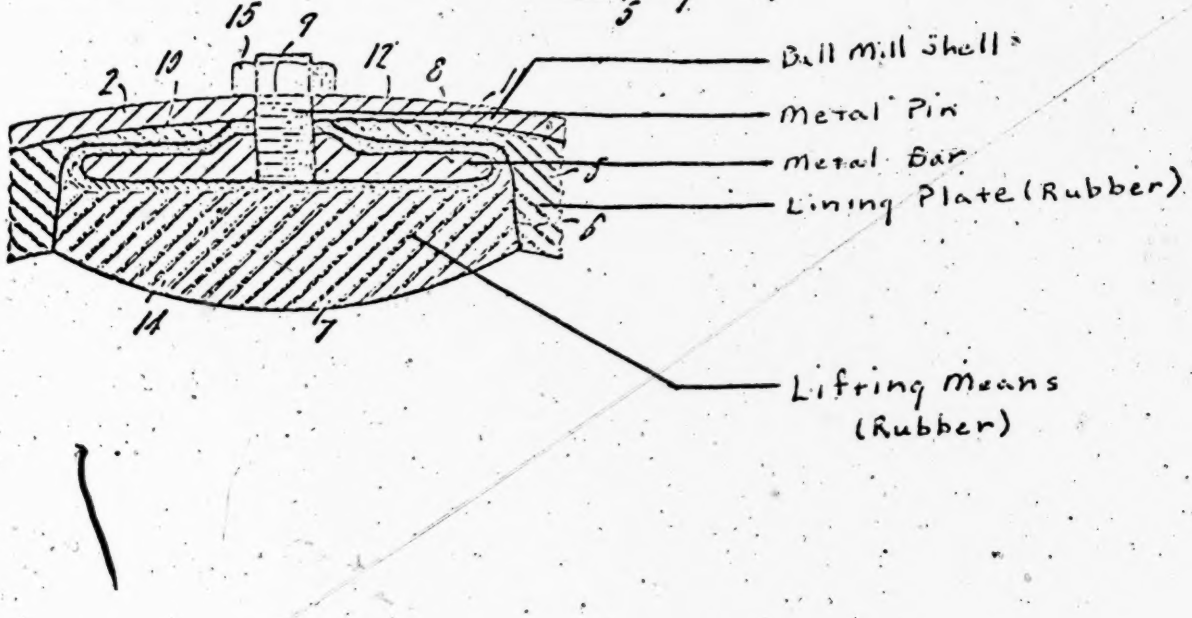


Fig. 2.



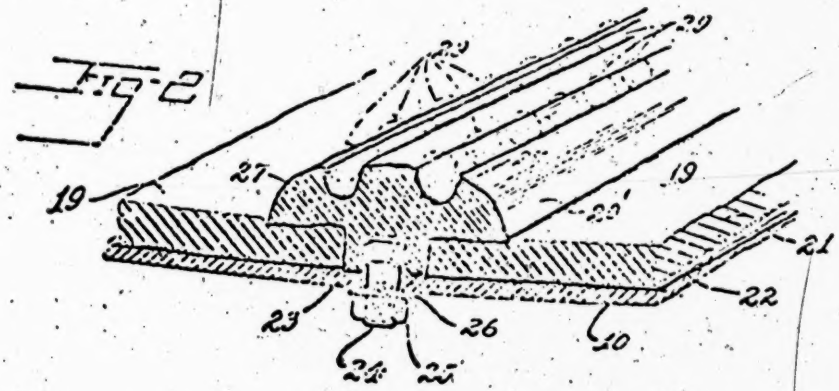
Appendix 3

Aug. 8, 1933. F. L. HAUSHALTER 1,921,672

BALL MILL LINING

Filed Dec. 21, 1931

Fig-2



A9

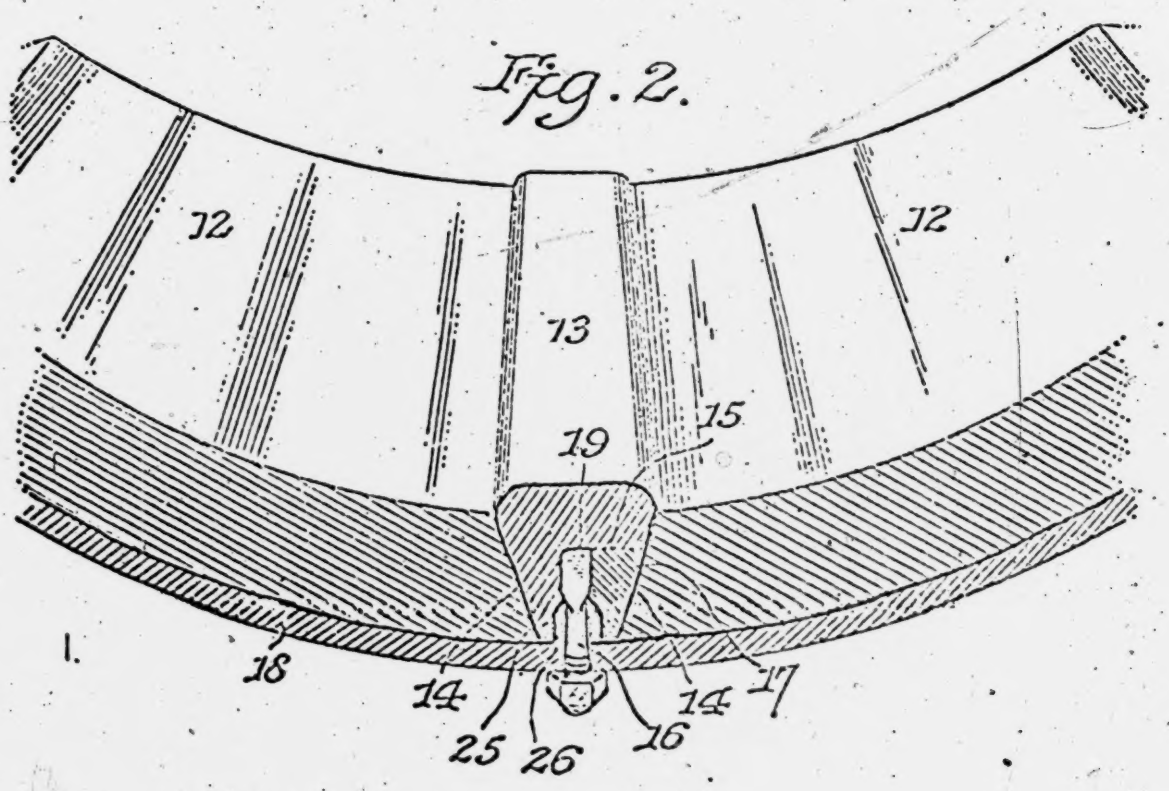
Appendix 4

E. W. LAWLER.
LINING FOR TUBE MILLS.
APPLICATION FILED DEC. 10, 1917.

1,315,025.

Patented Sept. 2, 1919.
2 SHEETS—SHEET 1.

Fig. 2.



A10

Appendix 5

Jan. 1, 1935.

A. M. READ

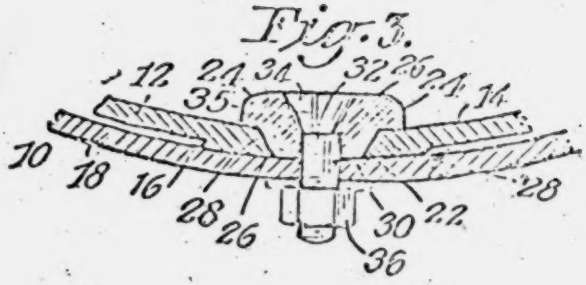
1,986,530

GRINDING MILL

Filed Sept. 10, 1932

A11

Fig. 3.



Appendix 6

(No Model.)

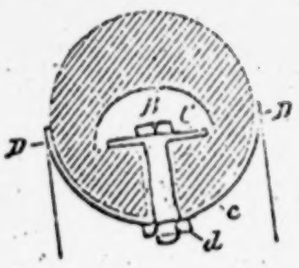
A. STRAUS.

RUBBER TIRE FOR VEHICLES.

No. 449,502. Patented Mar. 31, 1891.

A12

FIG. III.



Appendix 7

M. C. OVERMAN.

VEHICLE TIRE.

APPLICATION FILED DEC. 16, 1910.

1,092,073. Patented Mar. 31, 1914.

2 SHEETS-SHEET 1.

A13

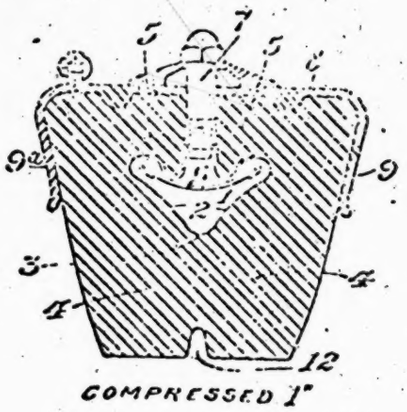


Fig. 2.

APPENDIX II.

JUDGMENT OF THE UNITED STATES COURT OF APPEALS FOR THE SIXTH CIRCUIT.

(Filed January 30, 1970.)

APPEAL from the United States District Court for the Northern District of Ohio.

THIS CAUSE came on to be heard on the record from the United States District Court for the Northern District of Ohio and was argued by counsel.

ON CONSIDERATION WHEREOF, It is now here ordered and adjudged by this Court that the judgment of the said District Court in this cause be and the same is hereby affirmed.

It is further ordered that Defendant-Appellee recover from Plaintiffs-Appellants the costs on appeal, as itemized below, and that execution therefor issue out of said District Court.

Entered by order of the Court.

CARL W. REUSS,
Clerk.

APPENDIX III.

ORDER OF THE UNITED STATES COURT OF APPEALS FOR THE SIXTH CIRCUIT ON REHEARING.

(Filed March 24, 1970.)

Before: PHILLIPS, Chief Judge, EDWARDS and CELEBREZZE, Circuit Judges.

Upon due consideration, Plaintiffs-Appellants' petition for rehearing is denied.

ENTERED BY ORDER OF THE COURT
CARL W. REUSS,
Clerk.

APPENDIX IV.

FINDINGS OF FACT AND CONCLUSIONS OF LAW BY THE UNITED STATES DISTRICT COURT FOR THE NORTHERN DISTRICT OF OHIO, EASTERN DIVISION.

FINDINGS OF FACT.

1. The plaintiffs in this action are Skega Aktiebolag, a Swedish joint stock company having a principal place of business in Ersmark, Sweden, and Allen Pump Company, a corporation of Pennsylvania with its principal place of business in Frazer, Pennsylvania.

2. The defendant herein is the B. F. Goodrich Company, a corporation organized under the laws of New York with its main offices and factories in Akron, Ohio.

3. The patent in suit (U. S. Patent 3,107,867), relating to rubber wear linings for grinding mills, was issued on October 22, 1963, and is owned by plaintiff Skega; plaintiff Allen Pump Company entered into an exclusive license agreement with Skega on June 28, 1966.

4. The complaint charges that the defendant has infringed the patent in suit by making, offering for sale, selling and installing mill linings which embody claims 1, 2 and 8 of the patent in suit.

5. The answer denies infringement and avers that the patent in suit is invalid; defendant also cross claims for a declaratory judgment holding the patent invalid and holding that there has been no infringement thereof.

6. The claims of the patent in suit which are alleged to have been infringed disclose: (1) a wear lining of rubber for rotary drums; (2) that the lining is composed of a plurality of adjacent sections of separate rubber lifting means; (3) that separate rubber lining plates are disposed between said lifting means; (4) that the lifting means are provided with an internal slot having bars inserted therein; (5) that the bars should have either threaded pins welded thereon or threaded holes inserted therein for holding the lifting means; and (6) that the rubber lining plates are held to the wall of the drum by a pressure exerted by the lifting means on the bottom walls of the recesses in the longitudinal edges of the rubber lining plates.

7. The accused devices consist of and embody a wear lining of rubber for rotary drums, comprising a plurality of adjacent sections of separate rubber lifting means and separate rubber lining plates disposed between the said lifting means provided with an internal slot having bars inserted therein, said bars being provided with either holes therein for carriage bolts or a channel in which a nut is inserted to receive a bolt or a threaded pin for holding the lifting means. (Exs. 61 and 62.)

8. The work performed by the carriage bolt of the accused device depicted in Exhibit 61 consists of exerting

a pressure in the direction of the drum upon the bar inserted in the lifting means such as to retain the lifting means, and also the lining plates, close to the inner wall of the mill drum; such work is the same as that performed by the pin disclosed in claim 1 of the patent in suit and by the combination of the pin or bolt and the threaded hole inserted in the bar as described in claim 2 of the patent in suit. The work performed by the combination of the threaded pin and the nut of the accused device depicted in Exhibit 62 is the same as that described above and is also the same as that of the pin disclosed in claim 1 of the patent in suit and the combination of the pin or bolt and the threaded hole inserted in the bar as described in claim 2 of the patent in suit.

9. The combination in the accused devices of either a hole in the bar in which is inserted a carriage bolt for holding the lifting means to the drum, or a hollow bar wherein a nut is inserted to receive a threaded pin or bolt for holding the lifting means, does the same work in substantially the same way to produce substantially the same results as does the combination disclosed by the patent in suit of either a bar wherein holes are inserted to receive threaded pins for securing the lifting means to the drum or a bar having threaded pins welded thereon for the same purpose.

10. The nuts, pins, and carriage bolts employed in the accused mill linings (Exs. 61 and 62), the pin disclosed in claim 1 of the patent in suit, and the pin or bolt used in combination with the threaded hole disclosed in claim 2 of the patent in suit are equivalent and do the same work by substantially the same means to accomplish substantially the same results.

11. The accused devices (Exs. 61 and 62) embody the same combination of elements, do the same work by sub-

stantially the same means, and accomplish substantially the same results as the invention claimed in the patent in suit by claims 1, 2 and 8 thereof.

12. The combination of (1) separate rubber lifters, or lifting means, (2) separate rubber liners, or lining plates which are disposed between and held in the drum by the lifting means, and (3) means for holding the lifting means and anchoring the same in the wall of the drum was old prior to the invention of the patent in suit. (Pltf.'s Admissions to Request No. 118; Svensson, Rpp. 191; Porteous patent No. 2,058,257, Ex. Y; Meyer, Rpp. 490-491; Kramer, Rpp. 802-803.) In the combination claimed in the patent in suit, only the means for holding the lifting means, in the same old combination, was altered or improved without making a new combination.

13. This same combination wherein the lifters were made of metal and the liners of rubber was also old prior to the invention of the patent in suit. (Haushalter patent No. 1,921,672, Ex. Z; Svensson, Rpp. 217-218; Haushalter, Rpp. 682; Meyer, Rpp. 534-535; Kramer, Rpp. 830.)

14. The same combination described in Finding 12 above wherein the lifters and liners were made of metal, and sometimes called the Lorain type lining, was also old prior to the invention of the patent in suit. (Patent in suit No. 3,107,867, col. 1, lines 27-35; Lawler patent No. 1,315,025, Ex. CC; Reed patent No. 1,986,530, Ex. DD.)

15. Substantially and essentially the same combination wherein the lifters and liners were made in one piece instead of two pieces, (1) symmetrically with the lifter part molded in the middle, and (2) asymmetrically, with the lifter part molded along one edge and overlapping the liner part on the other edge of the adjacent piece, was also old prior to the invention of the patent in suit. (Gammeter

patent No. 1,601,956, Ex. AA; Meyer, Rpp. 532-533; Kramer, Rpp. 828-829.)

16. The "lifting" action within a grinding mill includes a coaction between the weight of the materials within the drum and the friction between the lining surface and such materials or charge, as well as centrifugal force of the charge against the lining created by rotation of the drum, all of which results in a tilting of the charge when the drum is rotated so as to allow the balls or pebbles of the charge to roll from the uppermost portion of the charge mass surface, down the slope or tilt, to the lowest portion of the charge mass. Such lifting of the charge is therefore only partially determined by the projections upon the surface of the mill linings generally known as lifting means. (Kramer, Rpp. 1100-1102.)

17. Lifting means in ball mill linings were old, well known and used prior to the invention of the patent in suit. Such lifting means include (1) integral metal lifting means, including single-wave, double-wave and shiplap metal forms of linings (Ashe, Rpp. 370-372, Ex. 70.); (2) separate metal lifting means (Haushalter patent No. 1,921,672, Ex. Z; Lawler patent No. 1,315,025, Ex. CC.); (3) integral rubber lifting means (Gammeter patent No. 1,601,956, Ex. AA.); and (4) separate rubber lifting means (Porteous patent No. 2,058,257, Ex. Y.).

18. The scope of prior art to be considered in the determination of this case encompasses prior art relating to grinding mill linings generally, as well as that relating to means for attaching and securing rubber in a position where it would be subject to similar forces and stresses tending to detach and dislodge the rubber from such position.

19. The art of holding rubber cushion tires on the rims of road vehicle wheels is analogous to the art of hold-

ing rubber lifters in the drums of grinding mills. The stresses, forces and loads per unit area tending to abrade, wear and detach such tires from their rims are of the same, or substantially the same nature and kind and of similar or greater magnitude than those to which such lifters are subjected in the drums of ball mills. (Kramer, Rpp. 822-825, 1103-1106.)

20. The Straus patent No. 449,502 (Ex. EE) and the Overman patent No. 1,092,078 (Ex. PPP) disclose an attaching means for securing rubber tires to rims wherein a reinforcing metal member is inserted into a slot in the rubber of the tire forming a loose, rather than a bonded engagement with the rubber. The arrangement of the metallic member and the rubber tire is such that a substantial portion of the rubber is between the metallic member and the rim. Said patents also teach the use of bolts or pins as a means of drawing the metal reinforcing member toward the rim, thereby securing the rubber tire to said rim.

21. The Porteous patent No. 2,058,257, issued on October 20, 1936, relates to retaining means for rubber linings and claims as inventive (1) a metal retaining bar having a raised portion on one face for cooperation with a mill wall to provide spaces for clamping lining edges; (2) securing means for the bar on the raised portion connected to the mill wall; (3) a lining for the mill wall having edges secured between the bar and mill wall and having spaced inwardly extending portions; and (4) a rubber layer secured to the bar opposite the raised portion, said rubber layer being of substantially the same thickness as said portions and having outwardly flaring edges to provide a beveled fit therewith. (Ex. Y.)

22. Phillip F. Allen, while employed by Phelps-Dodge as mill superintendent at Bisbee, Arizona, in collaboration

with the Gates Rubber Company of Denver, Colorado, installed and operated a rubber lining for a ball mill in the Phelps-Dodge mill at Bisbee before any mill lined by plaintiffs was operated in the United States. (Allen, Rpp. 635-637; Defendant's Answer to Plaintiff's Interrogatory No. 11(a).) Allen and the Gates people had no knowledge of plaintiff's invention nor of the prior art exhibited in this case before they designed, installed and operated their first rubber lining (Exs. QQ, RR, and SS) on or about April 4, 1964.

23. The rubber linings designed by Allen and the Gates people were comprised of and embodied a plurality of adjacent sections of separate rubber lifting means, with separate rubber lining plates disposed between and held in place by the said lifting means. The attaching means for the lifters consisted of a metal reinforcing bar which was vulcanized and molded into the lifter, such bar being drawn to the drum and secured thereto by means of pins or bolts attached to the bar. (Exs. PP and XX.)

24. It was obvious to Allen to copy the form, arrangement and combination of steel lifters and liners, which he had known for years, to design and contrive his rubber liners. (Allen, Rpp. 630-632.)

25. It was obvious to Allen to use an attaching means which involved a metal reinforcing bar within the lifting means, as opposed to a bar which was vulcanized only to one side of the lifter as taught by the Porteous patent No. 1,058,257, in order to obtain a more secure attachment of the rubber lifter to the bar, and thereby a more secure attachment of the combination to the drum of the mill. (Allen, Rpp. 630-632.)

26. The level of ordinary skill in the pertinent art is substantially equal to that which is exhibited in the teaching of the patent in suit. (See Findings above.)

27. The difference between the patent in suit and the prior art, as to the Porteous patent No. 2,058,257, consists (1) of constructing the reinforcing bar of the lifting means separate from the lifting means, so that assembly of the combination of the lifting means and metal reinforcing bar involves insertion of the bar into the slot provided in the lifting means (Claims 1 and 2 of patent in suit), whereas the Porteous patent teaches a permanent bonding of such metal reinforcing bar into the rubber of the lifting means or retaining bar (Svensson, Rpp. 246); (2) of using pins inserted into threaded holes, pins welded onto the metal reinforcing bar, or pins inserted into threaded sleeves as the means for securing the metal reinforcing bar and the lifter to the drum walls (Kramer, Rpp. 802), whereas the Porteous patent discloses only the use of a pin threaded into a hole in the metal reinforcing bar for such purpose (Porteous patent, Ex. Y; Kramer, Rpp. 802); and (3) of constructing the lifting means so as to provide a substantial amount of the rubber material on the side of the reinforcing bar facing and nearest to the drum as well as on the side of the bar facing the interior of the drum, thus virtually surrounding the reinforcing bar with a substantial layer of rubber. The Porteous patent teaches, on the other hand, that the reinforcing bar is to be coated with an adhesive, then covered with a thin layer of rubber, and finally enclosed in a layer of fabric. An outer surface of rubber is then vulcanized to the fabric in such manner as to cover only that side of the reinforcing bar which faces the interior of the drum, thus leaving only the thin rubber coating and the fabric on that side of the bar facing and nearest to the drum wall.

28. The difference between the invention claimed in the patent in suit and that disclosed by the Straus patent No. 449,502 (Ex. EE) and the Overman patent No. 1,092,078 (Ex. PPP) lies primarily in the use intended for

each structure. Insofar as the Straus and Overman patents disclose a means for securing rubber wherein a metal reinforcing member is inserted into a slot in the rubber member and not bonded thereto, and pins or bolts are attached to the metal member to draw it up to the surface to which it is to be secured, such patents disclose the attaching means claimed in claims 1 and 2 of the patent in suit.

29. The difference between the prior art and claims 1, 2 and 8 of the patent in suit are trivial. (See Findings above.)

30. The scope and content of the prior art taught and embraced in substance all the solutions to all the problems which the patent in suit purported to solve. (See Findings above.)

CONCLUSIONS OF LAW.

1. This Court has jurisdiction of the parties and of the subject matter of this action.

2. Plaintiff Skega Aktiebolag is the owner of the legal title to the A. N. Svensson and B. Brandt United States Patent No. 3,107,867 in suit; plaintiff Allen Pump Company is the owner of the equitable title thereto by virtue of an exclusive license agreement dated June 28, 1966.

3. The accused forms of defendant's rubber mill linings embody the invention claimed in claims 1, 2 and 8 of the patent in suit.

4. Claims 1, 2 and 8 of the patent in suit are invalid under 35 U.S.C. 103 because the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been, and it was in fact, obvious at the time the invention

was made to persons having ordinary skill in the pertinent art.

5. The alleged invention of the patent in suit is invalid for comprising no more than a new use for the clamping means disclosed in Straus patent No. 449,502 and in the Overman patent No. 1,092,078 with merely the natural consequences thereof.

6. Since claims 1, 2 and 8 of the patent in suit are invalid, plaintiffs are not entitled to relief for any infringement of such claims by defendant.

7. Defendant has carried its burden of proving invalidity of claims 1, 2 and 8 of the patent in suit.

8. Judgment shall be entered for defendant on the complaint, and costs shall be given to it.

9. Judgment shall be entered for defendant on its first counterclaim. Since the claims of the patent in suit allegedly infringed are invalid, defendant's second counterclaim is dismissed as moot.

The foregoing is adopted as the Court's findings of fact and conclusions of law pursuant to Rule 52(a), Federal Rules of Civil Procedure.

Let an appropriate order in conformity herewith be submitted.

GIRARD E. KALBFLEISCH,
Chief Judge.

APPENDIX V.

FINAL JUDGMENT OF THE UNITED STATES DISTRICT COURT FOR THE NORTHERN DISTRICT OF OHIO, EASTERN DIVISION.

This action having been tried before the Court without a jury, Honorable Girard E. Kalbfleisch presiding, and evidence and briefs having been submitted by both parties, and the Court having heard and considered the same and having entered its Findings of Fact and Conclusions of Law, on or about 18th November 1968,

It is Hereby Ordered, Adjudged and Decreed that:

Plaintiffs' Complaint be dismissed.

Defendant has prevailed on its first counterclaim.

The Svensson et al. patent in suit No. 3,107,867, particularly claims 1, 2 and 8 thereof, is and are invalid.

Defendant recover from plaintiff its costs in this action to be taxed by the Clerk.

GIRARD E. KALBFLEISCH,
United States District Judge.

APPENDIX VI.

CONSTITUTIONAL PROVISIONS, STATUTES AND RULES INVOLVED.

Constitution of the United States, Article I, Section 8 (1787):

Section 8. The Congress shall have Power * * *.

* * * * *

To regulate Commerce with foreign Nations, and among the Several States, and with the Indian Tribes;

* * * * *

To promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries;

* * * * * *

Title 28 U.S.C. Section 1254. Courts of appeals; certiorari; appeal; certified questions.

Cases in the courts of appeals may be reviewed by the Supreme Court by the following methods:

(1) By writ of certiorari granted upon the petition of any party to any civil or criminal case, before or after rendition of judgment or decree;

* * * * * *

Title 35 U.S.C. § 101. Inventions patentable.

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Title 35 U.S.C. § 102. Conditions for patentability; novelty and loss of right to patent.

A person shall be entitled to a patent unless—

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for patent, * * *

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States, or

Title 35 U.S.C. § 103. Conditions for patentability; non-obvious subject matter.

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Title 35 U.S.C. § 282. Presumption of validity; defenses.

A patent shall be presumed valid. Each claim of a patent (whether in independent or dependent form) shall be presumed valid independently of the validity of other claims; dependent claims shall be presumed valid even though dependent upon an invalid claim. The burden of establishing invalidity of a patent or any claim thereof shall rest on the party asserting it.

Rules of the Supreme Court of the United States.

PART V. JURISDICTION ON WRIT OF CERTIORARI

19.

CONSIDERATIONS GOVERNING REVIEW ON CERTIORARI

* * * * *

1. (b) Where a court of appeals * * * has decided a federal question in a way in conflict with applicable decisions of this court; * * *

* * * * *

Federal Rule 52(a) of the Federal Rules of Civil Procedure.

RULE 52.

FINDINGS BY THE COURT

(a) *Effect.* In all actions tried upon the facts without a jury or with an advisory jury, the court shall find the facts specially and state separately its conclusions of law thereon, and judgment shall be entered pursuant to Rule 58; * * * Findings of fact shall not be set aside unless clearly erroneous, and due regard shall be given to the opportunity of the trial court to judge of the credibility of the witnesses. * * *

JUL 22 1970
E. ROBERT SEAVER, CLERK

In the Supreme Court of the United States

No. [redacted] 305

OCTOBER TERM, 1969.

SKEGA AKTIEBOLAG
(formerly Skelleftea Gummifabriks A.-B.)

and

THE ALLEN PUMP CO.
(Trading as The Allen-Sherman-Hoff Pump Company),
Petitioners,

vs.

THE B. F. GOODRICH COMPANY,
Respondent.

ON PETITION FOR WRIT OF CERTIORARI
TO THE UNITED STATES COURT OF APPEALS
FOR THE SIXTH CIRCUIT.

BRIEF OF RESPONDENT IN OPPOSITION.

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In the Supreme Court of the United States

No. 1737.

OCTOBER TERM, 1969.

SKEGA AKTIEBOLAG
(formerly Skelleftea Gummifabriks A.-B.)
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THE ALLEN PUMP CO.
(Trading as The Allen-Sherman-Hoff Pump Company),
Petitioners,

vs.

THE B. F. GOODRICH COMPANY,
Respondent.

ON PETITION FOR WRIT OF CERTIORARI
TO THE UNITED STATES COURT OF APPEALS
FOR THE SIXTH CIRCUIT.

BRIEF OF RESPONDENT IN OPPOSITION.

FOREWORD.

This is an ordinary action for patent infringement of an ordinary, invalid patent which has never before been litigated. This case meets none of the criteria required by this Court as reasons for granting review on certiorari as set forth in its Rule 19. Petitioners have phrased their "QUESTIONS PRESENTED FOR REVIEW," to conform to these criteria. In actuality, however, the decision of the Court of Appeals for the Sixth Circuit for which review is sought, is not in conflict with any decision of any other court of appeals on the same matter, nor with the trial court, nor

with the statute nor with applicable decisions of this Court. Petitioners seek to relitigate the issues on the merits which were decided uniformly against them in both courts below.

In *Layne and Bowler Corp. v. Western Well Works Inc.*, 261 U.S. 387, 67 L. ed. 712 (1923), this Court dismissed as improvidently granted a writ of certiorari granted to settle a conflict between decisions of two circuit courts of appeals with respect to the validity and scope of a patent where, upon examination, it was disclosed that there was in fact no conflict between the decisions.

In *Keller v. Adams-Campbell Co. Inc.*, 264 U.S. 314, 319, 68 L. ed. 705, this Court dismissed a writ of certiorari as improvidently granted where upon close examination it was found that no important question was involved concerning the rights of one beginning manufacture of an alleged infringing device before reissue of a patent. Mr. Chief Justice Taft stated: "Such an ordinary patent case, with the usual issues of invention, breadth of claims, and noninfringement, this Court will not bring here by certiorari unless it be necessary to reconcile decisions of circuit courts of appeal on the *same patent*." (Emphasis supplied.)

In *General Talking Pictures Corp. v. Western Electric Co. Inc.*, 304 U.S. 175, 178-179, 82 L. ed. 1273 (1938), this Court in refusing to consider questions raised in the brief on the merits and not brought forward in a petition for writ of certiorari, noted that there was nothing in the lower courts' decision on either of the added questions to warrant review by this Court. In so doing, Mr. Justice Butler stated: "Granting of the writ would not be warranted merely to review the evidence or inferences drawn

from it. * * * Nor would the writ be granted to review the questions of anticipation and invention that petitioner argues, for as to them there is no conflict between decisions of circuit courts of appeals."

Nor is there any occasion at bar to review the merits of the patent in suit. No other courts have decided anything about the patent in suit. Moreover, the patent in suit is, on the face of the decisions of the courts below, without noticeable merit anyhow. The trial court found and the Court of Appeals affirmed that the difference between the patent claims in suit and the prior art was "trivial." Finding of Fact No. 29, AP 24.* This is a broad general finding which refers to its preceding supporting findings, such as: Nos. 6, 12 and 15 that the claimed combination was old with only the means for holding the lifting means "altered or improved"; Nos. 16 and 17 describing the lifting action and the antiquity of integral as well as separate lifting means; No. 19 that the stresses, forces and load tending to detach tires from vehicle rims are substantially the same as those to which lifters, i.e. lifting means, are subjected in ball mills; No. 20 that the prior Straus and Overman patents taught, in substance, the same means for holding the old rubber cushion tires in their rims as claimed in the patent in suit; No. 28 that the *difference* between Straus and Overman and claims 1 and 2 of the patent in suit "lies primarily in the use for each structure"; No. 21 describing the teaching of the prior Porteous patent and, No. 27 specifying the precise and minute *difference* between Porteous and the patent in suit.

---

* Our references to the Appendices to the Petition will be abbreviated to "AP" followed by the page number.

NO QUESTION IN THIS CASE IS WORTHY OF REVIEW.

Respondent's position is that nothing done or omitted by the courts below raised any question worthy of or warranting review by this Court. This Court in its sound judicial discretion will discover and decide whether or not there are special and important reasons for granting the Petition. Respondent contends there are none.

Petitioners' questions include the bold assertion that the Court of Appeals for the 6th Circuit, the District Court for the Northern District of Ohio, *as well as "the Federal Courts generally,"* do not understand, or are *unable to understand,* what this Court taught and required on the point of obviousness in *Graham v. John Deere, Calmar and Colgate v. Cook,* 383 U.S. 1, *U. S. v. Adams,* 383 U.S. 39, *Anderson's-Black Rock v. Pavement Salvage,* 396 U.S. 57 cited in the Petition, and, necessarily, *Hotchkiss et al., v. Greenwood et al.,* 11 Howard, 248, 265.

Respondent's attorneys suggest that there is nothing about the case at bar to invite review by this Court of whether or not its illustrious decisions in these cases are "understandable by the Federal Courts generally." It should suffice to show here that the courts below in this case lacked no understanding of this Court's teaching in these cases.

How petitioners aimed to interest this Court in the QUESTIONS PRESENTED FOR REVIEW was obscure to respondent's attorneys until they noticed petitioners' repeatedly and mistakenly asserted premise that "The *relevant and material facts* in the case *are undisputed.*", (emphasis supplied), page 6, lines 6 and 7 of the Petition and again in substance on page 10, under the heading "Utility and Novelty," and again on page 19 in the first paragraph of the text saying, "In the present case *the facts*

were not in dispute; the findings are descriptive and conclusionary (sic)." (Emphasis supplied.)

By asserting that the relevant and material facts were not in dispute, petitioners have allowed themselves (1) to fill their Petition with many mistaken factual recitations as if true and undisputed, and (2) to advert to the findings of fact made by the trial court as if they were merely irrelevant gratuities or conclusions of law or law and facts, beyond the scope of Rule 52 (a), and in breach of *Graham*, *Calmar* and *Anderson's-Black Rock*.

Respondent asserts that the relevant and material matters of fact which were critical to decision and judgment in this case were vigorously disputed. The trial court's repeated reference to the testimony of the witnesses for both parties in its findings of fact Nos. 12, 13, 15, 16, 17, 19, 22, 24, 25 and 27 demonstrates its thoughtful resolution of many disputed questions of relevant and material facts.

RESPONDENT'S COUNTERSTATEMENT OF THE CASE.

PROCEEDINGS IN THE COURTS BELOW IN THIS CASE, PAGE 5 OF THE PETITION.

Early in the proceedings in the trial court plaintiffs-petitioners variously accused two substantially identical forms of defendant's products as infringing the patent in suit. In one form the metal reinforcing bar in the rubber lifter was vulcanized and bonded into the lifter following the teaching of the prior art Porteous patent, AP 7. In the other form, the metal reinforcing bar was "loose," not vulcanized or bonded in the rubber body of the lifter, following the teaching of prior art Straus and Overman patents, AP 12 and 13. Bolts from the metal bars to the ball mill shell or drum secured the bars and lifters which

in turn secured the liners of both forms in the same way in and to the drum or shell of the mill. On discovery in about May, 1967, the vulcanized form was excused from the charge of infringement. The unvulcanized or "loose" form was then alone accused. By the second amendment to the Supplemental Complaint in December, 1967, the vulcanized form was also accused. Before the trial the vulcanized form was again excused. This conduct will be related to petitioners' abandonment of its claim to its vulcanized form in the U.S. Patent Office, page 9 below.

Conclusion of Law No. 4 held the claims in issue of the patent in suit invalid under Sec. 103.

Conclusion of Law No. 5 held the alleged invention of the patent in suit nothing but a new use for the cushion tire holding or clamping means of the prior Straus and Overman patents.

Conclusions of Law Nos. 6 and 8 held the issue of infringement to be moot.

Conclusion of Law No. 7 held defendant had carried its burden of proving invalidity of the claims in issue of the patent in suit.

The Court of Appeals for the 6th Circuit affirmed the trial court's finding that the combination claimed in the patent in suit was an old combination within the scope of the prior art, AP 2. The Court of Appeals not only affirmed that finding but *also* affirmed the trial court's further findings and/or conclusions that the patent in suit was obvious, AP 4.

The Court of Appeals made its own examination of the prior art patents to Porteous, Haushalter, Lawler and Reed and *made its own findings* about likeness as between the prior art features, retaining means and combinations and the patent in suit, AP 2 and 3.

The Court of Appeals found "no merit in the Appellants' contention that the art of securing rubber tires to metal rims is not analogous to the art of securing lifting means to ball mill shells.", and quoted and endorsed the trial court's finding No. 19 in respect to the sameness of the loads and forces tending to detach tires from their rims and lifters from ball mill drums. And the Court of Appeals endorsed the trial court's finding that if the Svensson patent in suit contained any novelty in respect to the holding means of Porteous, "it was merely a new use of the clamping means" of Straus and Overman, AP. 3 and 4.

THE BACKGROUND AND NATURE OF THE PATENT IN SUIT, PAGES 6-9 OF THE PETITION.

Respondent will try to avoid arguing the merits and criticizing harmless, irrelevant material.

This case involves a situation substantially identical with *Graham*, *Calmar* and *Anderson's-Black Rock*, and, therefore quite unlike *U. S. v. Adams* as the decisions and findings at bar in the courts below demonstrate.

"The relevant and material facts in" this "case" were vigorously "disputed," as shown above. Petitioners' assertions to the contrary, page 6 of the Petition, are mistaken and misleading.

Petitioner to the contrary notwithstanding, page 7 of the Petition, the Gammeter patent was used by respondent with fine commercial acceptance and success. An early installation of a Gammeter type rubber lined mill was made by respondent at the Homestake Mine in about 1925. Six years later the chief metallurgist of the Homestake published an article telling about the continued success of this rubber lined mill and the Homestake's replacement of iron linings by rubber linings because of the superior performance of the latter.

Contrary to Petitioners' statement on page 8 of their Petition, there is no evidence in this case that the Porteous lining failed to pass any test, or that any vulcanized bond between rubber and metal broke under impact forces of the mill charge.

Petitioners would have it on page 8 of their Petition that their ball mill linings were the very first rubber linings to meet the technical requirements of the industry, that all previous efforts failed, that numerous experts, including respondent's, worked continuously for 40 years in a vain effort to solve practical problems of fastening the rubber slabs to the mill shell, and that the patent in suit solved all the problems that plagued the art. The trial court found in its finding No. 30, AP 24:

> "30. The scope and content of the prior art taught and embraced in substance all the solutions to all the problems which the patent in suit purported to solve. (See Findings above.)"

There is no competent evidence of any failure of rubber ball mill linings, except that petitioners' Mr. Svensson testified that Skega's first designs according to Fig. 3 of the patent in suit failed in use in ball mills and had to be redesigned to withstand that hard usage, Petitioners' brochure, Ex. 63 opposite page 8 of the Petition. It is true, as petitioners do not mention, that the relatively high cost of rubber compared to the low cost of cast metal made the use of rubber linings noncompetitive from about the time of World War II until the 1960's.

Petitioners' self-serving romancing about the virtues and accomplishments of the patent in suit on page 8 of the Petition are unworthy of our adversaries and remote from the evidence in this case. The record shows that respondent reentered the rubber ball mill lining business in the '60's when the relative price of rubber and steel in the

United States returned to what it was in the '20's and 30's when respondent first successfully pioneered and promoted the art.

Petitioners neglected to mention that two forms of their invention are described and praised equally in the Svensson patent. In the form shown in Figure 3 of the patent at AP 5 attached to the Court of Appeals decision, the clamping bar 6 is "inserted" (meaning removably inserted) but not vulcanized and secured in the slot 5 in the lifter 3. In Figure 4 the clamping bars 9 and 11 are placed in and vulcanized in the corresponding slots in the lifters 10. Mr. Svensson, one of the inventors and general manager of petitioner, Skega, admitted the essential equality of these forms on cross-examination.

The original claims of the Skega patent application as originally filed included clamping means merely "inserted" (but not vulcanized) in the slot in the lifter or, alternatively, "secured by vulcanization." The Porteous patent was cited against the claims of the Svensson application. The clamping bar 8 in the Porteous patent AP 7 was vulcanized in the lifter. To distinguish from Porteous, petitioner, Skega, abandoned its effort to cover rubber lifters with metal bars vulcanized therein. Similarly, petitioners dropped their accusation of respondent's vulcanized form, page 6 above.

By yielding one of two equal forms of its alleged invention, petitioner gained a patent for the other.

Petitioners propose on pages 9 and 10 of the Petition that silence in the decisions below about the presumption of validity speaks in petitioners' favor on that point. But the trial court's Conclusion of Law No. 7 that defendant (-respondent) "carried its burden of proving invalidity" disposed of the presumption. Petitioners say on page 10 of the Petition that utility and novelty of the patent in suit

"have been admitted or not contested." In the sense that the patent in suit teaches and claims only an old combination, Findings 12-15, AP 19 and 20, utility of the old combination is clear enough and utter lack of novelty is also clear. In the sense that one element, the attaching or holding means, of the old combination was improved, Finding 12, novelty might have appeared, but even the attaching and holding means was old, Findings 20 and 28, AP 21 and 23 and Court of Appeals first paragraph AP 4.

ARGUMENT.

RESPONDENT'S OPPOSITION TO PETITIONER'S REASONS FOR ALLOWANCE OF THE WRIT.

The Basic Factual Inquiries of Graham v. John Deere Were Applied Correctly by the Courts Below in This Case:

This chapter will respond to petitioners' argument comprising pages 10-17 inclusive, of the Petition. Whereas petitioners protest the failure of the courts below to understand or follow *Graham*, examination of these pages reveals that petitioners' principal grievance is that the courts below refused to adopt petitioners' proposed findings to the effect that the prior art was a failure. Petitioners call this the "central issue"—"the failure of the prior designs" etc. This is plain and simple reargument of the same untenable contention on the merits which the trial court rejected once and the Court of Appeals rejected twice; the second time on Petition for Rehearing. On page 14, petitioners protest the courts below didn't find enough differences between prior art Porteous and Skega wherefore the courts below failed "to meet the substantive requirements of Graham." This is absurd. On the merits Mr. Svensson admitted the substantial and essential iden-

tity between Porteous and the patent in suit. On the issue at law on the Petition here, nothing in *Graham, Calmar* or *Anderson's-Black Rock* requires any court to make mistaken or unsupportable findings of fact to correspond with romantic theories of the unsuccessful party.

Petitioners reveal their primary and continuous ambition to reargue the now thrice briefed merits of the case by saying on page 15 of the Petition:

> "*We frankly feel* that the structure, operation and function of rubber lined ball mills is so distant from that of the old solid rubber tires * * *." (Emphasis ours.)

But the trial court heard conflicting testimony on this point and found for respondent in Finding 19, AP 20.

The rest of petitioners' argument through page 17 of the petition repeats and repeats the mistaken theory that respondent failed to solve "the problem" and the courts below failed to agree with petitioner on this point. This has nothing to do with the Questions that petitioner has presented for review.

Petitioners protest against the trial court's findings, Findings Nos. 22-25, that it was obvious to the witness Phillip F. Allen to follow the prior art and solve the "problem" allegedly waiting solution by the patent in suit. The trial court's findings were based on Allen's testimony in open court, direct and cross, supported by his contemporaneous documentary evidence and original physical exhibits. The findings are eminently proper. They are confined to the original work done by Allen and the Gates people and to the fact that "It was obvious to Allen * * *." This plain and simple fact certainly weighed in the scale of evidence about the "level of ordinary skill in the pertinent art." Petitioners' concern with the merits is not relevant to the Questions presented by them for review.

The basic factual inquiries relevant to the determination of obviousness or nonobviousness as stated in *Graham* are repeated here, as follows:

> "Under Section 103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background, the obviousness or nonobviousness of the subject matter is determined."

In this case the district court correctly applied these tests in making its findings of fact and conclusions of law.

Finding No. 18, AP 20, determined the scope and content of the prior art relevant to the patent in suit as encompassing not only the ball mill art but also the art of clamping rubber cushion tires to the rims of vehicles. Findings Nos. 12 to 17 and 21, AP 19-21, describe the content of the prior art of ball mill linings. In Finding No. 19 the trial court determined that the art of holding rubber cushion tires on the rims of road vehicles is analagous to the art of holding rubber lifters in the drums of rotary grinding mills. In Finding No. 20, the trial court found the content of the art of securing rubber cushion tires to the rims of vehicle wheels in the prior Straus and Overman patents.

The particular differences between the rubber lined ball mill art and the combination claimed in the patent in suit are set forth in Findings 12 and 27 and in comparison with Finding 6 about the patent in suit. Finding No. 27 is directed to the difference between the Porteous patent and the Svensson patent in suit. Finding No. 12 established the identity between the old combination of the same elements in the prior art and in the patent in suit. This narrowed the area of possible difference down to the trivial difference between the vulcanized bond of the reinforcing

bar in the Porteous lifter (as also disclosed and praised in Fig. 4 of the patent in suit) AP 5, and the unvulcanized, but equal, relation of the bar to the lifter of Fig. 3 of the patent in suit, AP 5.

It is mentioned in passing that the old combination of the Glencoe patent in *Graham*, the old combination of the Livingstone patent in *Calmar*, and the old combination discussed in *Anderson's-Black Rock*, each narrowed the area of difference that distinguished the patents there in suit to the "inconsequential" as contended by and found for *Calmar*.

Finding No. 12, in the last sentence thereof, expressly found that the difference, if any, between the Porteous patent and the patent in suit lay in the means for holding the lifting means. See also Finding 21, AP 21. Even if this particular sentence of Finding 12 be deemed conclusory, it is based on the prior primary findings in Finding 12 and the specific findings in Nos. 20 and 27 and is fully supported thereby. In sum, Findings 12 and 27 laid the foundation for Finding 29 that the difference between the prior art and the Svensson patent in suit is "trivial."

As to the holding or attaching means itself, Finding 28, AP 23 & 24, determined that attaching means in the Straus patent and in the Overman patent is the same as the attaching means in the patent in suit and does the same work in the same way; the difference between the two lying primarily in the use intended for each. This reduced the difference to very little indeed.

Petitioners complain that there is no valid evidence and no valid findings as to the level of ordinary skill in the pertinent art. We suggest that the level of ordinary skill is determined in large part by the content of the prior art. Contributions to the art continually update and increase the level of ordinary skill. This is a purpose and one of

the principal rewards of our patent system. It comprises the glow and vitality of the public domain in the useful arts. One at the level of ordinary skill in the art is one who is blessed with and is capable of applying the wealth of the public domain to solving work-a-day problems as they arise. The work of the witness Phillip F. Allen is a concrete example. Proceeding independently with no knowledge of the Skega lining or the patent in suit, Allen designed, installed and operated a rubber lining for a ball mill as set forth in Findings 22 to 25 as discussed above. His work was contemporaneous with Skega in the United States.

Petitioners complain that some of the findings of the trial court are conclusory. The other findings of basic facts from which the allegedly conclusory Findings are inferred, or upon which they are predicated, are dismissed by petitioners as being "simply descriptive" of the prior art and "merely neutral background material." But compare *Commissioner v. Duberstein*, 363 U.S. 278, 292, 4 L. ed. 2d 1218 (1960). In the cited case this Court held findings of fact insufficient where the trier of fact made only the simple and unelaborated finding that a particular transfer of property constituted a "gift." At bar the findings that are dubbed by petitioners as "simply descriptive" and "merely neutral background material" comprise findings made on disputed facts from which the findings about which petitioners complain, are logically inferred. The findings at bar are not "simple and unelaborated" as in *Commissioner v. Duberstein*, but are taken with and supported by explicit concrete findings at the root and premises of the truth.

The Court of Appeals Did Not Use Rule 52 (a) Incorrectly to Limit or Avoid Its Review of the Question of Obviousness:

Petitioners contend that the Court of Appeals below avoided reviewing reviewable findings and conclusions as if it were restrained by the "clearly erroneous" limitation. The Court of Appeals did not so confine the scope of its review. The Court of Appeals affirmance of the judgment, findings and conclusions of the trial court was so wholehearted that it had no occasion to question its power to test any particular finding or conclusion.

In *Cordovan Associates, Inc. v. Dayton Rubber Co.*, 290 F.2d 858 (1961), the Sixth Circuit Court of Appeals reconsidered on remand from this Court, *Dayton Rubber Co. v. Cordovan Associates*, 364 U.S. 299, a decision involving the "clearly erroneous" rule in light of this Court's decisions in *Commissioner v. Duberstein, supra.* In *Cordovan Associates,* the Court of Appeals stated its understanding of the law relating to the scope of appellate review under the eye of this Court. Respondent respectfully suggests the Court of Appeals for the Sixth Circuit understood and stated the law correctly in *Cordovan Associates* and applied it correctly in the case at bar.

No Conflict Between 6th, 4th and 9th Circuits:

Payne Metal Enterprises, Ltd. v. McPhee, 385 F.2d 541 (9th Cir. 1967) and *Tidewater Patent Development v. Kitchen,* 371 F.2d 1004 (4th Cir. 1966) which Petitioners allege are in conflict with the Sixth Circuit Court of Appeals decision in this case stand for the same propositions of law about appellate review as stated in *Cordovan Associates* and applied here at bar.

In *Cordovan Associates* the 6th Circuit Court stated that the "clearly erroneous" rule applied not only to basic

facts but also to factual inferences drawn from undisputed or well founded basic facts. Further, the court stated that not all findings labeled as findings of fact are binding on an appellate court. Where a finding so designated is actually a conclusion of law or a mixed finding of fact and conclusion of law it is not binding on the appellate court. If a finding is one of ultimate fact in the making of which the application of legal principles is involved, it is subject to review.

The Court of Appeals in *Cordovan Associates* then considered a particular finding of the district court, and held it must be considered with the other findings and not separate and apart from them, and held it to be a reviewable conclusion of law or a reviewable mixed finding of fact and law.

Cordovan Associates demonstrates plainly that the Sixth Circuit Court of Appeals is quite aware that it is not bound by findings of fact that contain, or border on conclusions of law.

In *Tidewater Patent Development v. Kitchen, supra,* contended by Petitioners to be in conflict with the decision of the Court of Appeals in this case, the Fourth Circuit Court of Appeals merely refused to follow legal conclusions of the trial court which were apparently called findings of fact. The Court noted that most of the evidence was documentary and could be examined by it as well as by the trial court, which the Appeals Court proceeded to do and then corrected the erroneous conclusion of the trial court.

In *Payne Metal Enterprises v. McPhee, supra,* which Petitioners contend is in conflict with the Court of Appeals decision in this case, the Ninth Circuit Court of Appeals merely refused to be bound by a conclusion of nonobviousness though labeled a finding of fact, just as the Sixth

Circuit Court of Appeals refused to be so bound in the *Cordovan* case. The Ninth Circuit Court of Appeals then considered the prior art patents and corrected the erroneous conclusion of law made by the trial court.

On page 18 of the Petition petitioners have omitted from their quotation of the Court of Appeals' decision substantially all the Court said and did on AP 3 and the first paragraph of AP 4. These omitted parts demonstrate that the Court of Appeals functioned freely in its review, modification and affirmance of the trial court's findings and conclusions without any mistaken inhibition from the "clearly erroneous" rule.

Beginning at the top of AP 3 the Court of Appeals made its own independent comparison of the Porteous patent with the Svensson patent in suit, saying of Porteous that it "comprised the same features and used identical retaining means * * * homologous to the Svensson lifting means." This finding of "identical retaining means" in Porteous and in the patent in suit went a step further than the trial court's Finding of Fact No. 12, AP 19, which suggested that the retaining means of Porteous was "altered or improved" in the patent in suit.

Further in respect to the old combination of the lifters, liners and holding or retaining means of Porteous in comparison with the Svensson patent in suit, the Court of Appeals categorically endorsed the trial court's Finding No. 28, AP 23-24, and Conclusion of Law No. 5, AP 25, saying, "that if Svensson's" retaining means "was novel at all, in light of the Porteous patent" it was merely a new use of Straus and Overman.

The Court of Appeals then made its own examination of the Haushalter patent, and found the identity between Haushalter and the patent in suit in explicit affirmation of the trial court's Finding No. 13, AP 19.

Similarly the Court of Appeals made its own examination of the Lawler and Reed patents and made its own finding in affirmation of the trial court's Finding No. 14, AP 19, saying that it found in Lawler and Reed "virtually the identical combination" compared with the patent in suit except for changing the material from metal to rubber.

Then the Court of Appeals beginning in about the middle of AP 3, made its own review in law and in fact on the point of whether or not the art of securing rubber cushion tires to the rims of vehicles was analogous to the art of securing lifters in and to the drums of ball mills. It cited authority at law and quoted from the trial court's Finding No. 19, AP 20 and 21, in fact in respect to the work done by the clamping means in both instances; the trial court citing the testimony of defendant's expert witness, Kramer, in support of its finding.

These uninhibited acts and deeds of the Court of Appeals illumine the second of the two paragraphs of its decision which petitioners quoted on page 18 of the Petition. Respondent suggests that the first phrase of the paragraph is a recap of its and the trial court's findings and/or conclusions that the patent in suit comprised merely an old combination wherein one element, if "novel at all, in light of Porteous" was "merely a new use" etc. Respondent also suggests that the second phrase beginning "but also that it was obvious * * * to persons having ordinary skill in the art of clamping rubber to metal" comprised its affirmation of a second and independent group of findings and conclusions of fact, mixed fact and law and law based on the testimony of Appellee's witnesses Kramer and Allen, among others, Findings 16, 19, 22-25, the logical inferences therefrom, Findings 26, 29 and 30 and the Conclusions of Law Nos. 4, 5, 6 and 7.

The concluding sentence of this paragraph reading,

> "In so crediting the testimony of the Appellee's experts we cannot say that the District Court erred in fact or law. Rule 52(a),"

taken with the things the Court of Appeals did in the preceding parts of its decision, as discussed above, forbids one to say that the Court gave more than proper heed to the trial court's findings on disputed testimony because it reviewed or made all other findings, conclusory findings and conclusions of law or mixed fact and law as uninhibitedly and thoughtfully as this Court taught, exemplified and required in *Commissioner v. Duberstein; Dayton Rubber Co. v. Cordovan Associates,* 364 U.S. 299, 5 L. ed. 2d 90; *Graham, Calmar* and *Anderson's-Black Rock.* It follows that the Sixth Circuit Court of Appeals fell into no conflict in this respect with the Courts of Appeal of the Fourth and Ninth Circuits.

Nothing about United States v. Adams Suggests the Skega Patent Should Have Been Sustained:

Firstly, "the Adams battery is novel" 383 U. S. 39, 50. Secondly, "the Adams battery was also nonobvious," as this Court found and affirmed on page 51 of the official report. Nothing before this Court on or appended to the Petition suggests either novelty or nonobviousness in the Svensson patent in suit.

SUMMARY AND CONCLUSION.

The Petition is overburdened with reassertion of and reargument about the merits upon which petitioners failed to carry their burden in the courts below. Respondent has shown that petitioners' representations to this Court that the relevant and material facts in this case were *undisputed* were gravely mistaken, but were necessary premises to support the Petition. Since many relevant, material and basic facts were found by the trial court on conflicting testimony and disputed evidence, and petitioners' premises about undisputed facts are invalid, petitioners' argument and conclusions based thereon must fail.

Respondent contends it has also shown that the Questions Presented for Review by petitioners, and their Reasons for Allowance of the Writ, were predicated on corollaries to petitioners' mistaken premises, namely, that the courts below made, reviewed and affirmed findings of fact that had nothing to do with the case, and were mere "background material", avoiding the "central issue" of Skega's success compared with the failure of the prior art. Petitioners' real complaint is the courts below failed to make findings and draw conclusions pleasing to petitioner.

With everyone out of step but petitioners, it is not to be wondered that they have tried to interest this Court in the proposition that *Graham, Calmar* and *Anderson's-Black Rock* are not "understandable by the Federal Courts generally." Respondent suggests this also reveals the fallacy and futility of petitioners' plea.

Respondent has shown that the courts below understood and followed *Graham, Calmar* and *Anderson's-Black Rock* carefully and wisely in respect to obviousness and otherwise, and made the inquiries required in those cases. Respondent has shown the parallel between the

evidence at bar and in these cited cases in respect to the patentees wrongful efforts there and here to recapture old combinations and remove them from the public domain.

The courts below also made the basic inquiries required in *Graham et seq.* into the facts that demonstrated obviousness in the mere double use of the old and "improved" holding or attaching means of the prior art as in *Hotchkiss v. Greenwood.*

Respondent has also demonstrated the absence of noticeable conflict between the 6th, 4th and 9th Circuit Courts of Appeal in respect to their duty and willingness to review findings and conclusions without breach of the letter or substance of Rule 52 (a).

In sum, respondent suggests it has shown the propriety and correctness of all the works done by the courts below in this case. It has shown the closeness of this case to the leading authorities of this Court in point of obviousness and the remoteness of this case from *U. S. v. Adams.* And respondent has shown that this is an ordinary action for patent infringement of a very ordinary patent presenting no important question for this Court to review.

Respondent respectfully solicits this Court's denial of the Petition.

Respectfully submitted,
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Cleveland, Ohio,
20th July, 1970.

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In the Supreme Court of the United States

OCTOBER TERM, [redacted] 1970

No. 305.

SKEGA AKTIEBOLAG
(formerly Skelleftea Gummifabriks A.-B.)
and
THE ALLEN PUMP CO.
(Trading as The Allen-Sherman-Hoff Pump Company),
Petitioners,

vs.

THE B. F. GOODRICH COMPANY,
Respondent.

PETITIONERS' REPLY BRIEF ON THEIR PETITION FOR WRIT OF CERTIORARI.

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PETITIONERS' REPLY BRIEF ON THEIR PETITION FOR WRIT OF CERTIORARI.

I.

Respondent's Brief, dated 20th July, 1970, makes it clear that Respondent cannot answer, and has sought to direct attention away from, the main thrust of the Petition, i.e., Petitioners' position.

On Page 2, that Brief attempts to direct attention away from Petitioners' position by asserting that Petitioners are "seeking to relitigate the issues on the merits," and on page 4, dismisses that position as being "a bold assertion."

II.

Petitioners did not "seek to relitigate the issues on the merits." Petitioners referred to one of the "factual inquiries" in the *Graham* case to show that the decisions in

this present case did not follow the rule of the *Machine Co.* and *Bates* cases. In making that point, it was necessary to refer to certain facts to inform the Court of what was involved.

Incidentally, Respondent is guilty of the very thing that it charges against Petitioners; i.e., dealing extensively with fact issues. Although it is said on page 7 of the Answer Brief that Respondent "will try to avoid arguing the merits," that Brief shows that Respondent failed in that effort and also made several statements which Respondent knew or should have known were false.

III.

Respondent's principal "answer" to the Petition was an assertion that there were many disputed relevant and material facts in the case contrary to our claim. See Respondent's Brief pp. 4, 5, 7, 11, 20, 4-14. The "answer" does not seem responsive to the legal issues in the Petition. In any case, however, we are satisfied that indeed there are no such disputed facts (as distinguished from conclusions) as is evident from the findings of the trial court, and can readily be ascertained from the Record. Interestingly, despite its fervor on the point, Respondent failed to set forth a single such disputed fact.

IV.

The position of Petitioners is that (1) the *Graham* case did not bar the application of the rule of the *Machine Co.* and *Bates* cases, and (2) the courts below generally, and the courts in this case particularly, did not understand the *Graham* case to mean that they should continue to follow the rule of those cases. The rule of those cases is that in determining the validity of a patent, each of the three factors of structure, mode of operation and results

must be considered. That position was broadly stated on pages 3 and 11 of the Petition and was concisely stated on pages 14 and 15 where the *Machine Co.* and *Bates* decisions of this Court were cited and quoted as authority.

Respondent has completely evaded those parts of the Petition and has not denied Petitioners' assertion that the courts below did not follow the rule of the *Machine Co.* and *Bates* cases.

This Court first stated the foregoing rule in the case of *Seymour v. Osborne*, 11 Wall. 516, 518 which was decided in December, 1870.

That rule was clarified and expanded to apply to both infringement and validity in the cases of *Machine Co. v. Murphy*,[1] 97 U.S. 120, 125 (1877) and *Bates v. Coe*, 98 U.S. 31, 42 (1878). A quotation in the *Bates* case appears on page 14 of the Petition.

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[1] On page 125, this Court said:

"Except where form is of the essence of the invention, it has but little weight in the decision of such an issue, the correct rule being that, in determining the question of infringement, the court or jury, as the case may be, are not to judge about similarities or differences by the names of things, but are to look at the machines or their several devices or elements in the light of what they do, or what office or function they perform, and how they perform it, and to find that one thing is substantially the same as another, if it performs substantially the same function in substantially the same way to obtain the same result, always bearing in mind that devices in a patented machine are different in the sense of the patent law when they perform different functions or in a different way, or produce a substantially different result.

"Nor is it safe to give much heed to the fact that the corresponding device in two machines organized to accomplish the same result is different in shape or form the one from the other, as it is necessary in every such investigation to look at the mode of operation or the way the device works, and at the result, as well as the means by which the result is attained.

(Continued on following page)

The rule of the three foregoing cases was followed by this Court from time to time down to 1966 when the *Graham* case was decided. Some of the cases following that rule are listed as follows:

Loom v. Higgins, 105 U.S. 580, 591 (1881);
Expanded Metal Co. v. Bradford, 214 U.S. 366, 380 (1908);
Mineral Separations, Ltd. v. Hyde, 242 U.S. 261, 268 (1916);
Electric Cable v. Edison, 292 U.S. 69, 80 (1934);
Graver Mfg. Co. v. Linde Co., 339 U.S. 605, 608 (1949).

It is believed that this Court has never deviated from that 100-year old rule.

That Petitioners' position as to the failure of the courts in this case to follow *Machine Co.* and *Bates* is sound and unanswerable is shown on pages 14 and 15 of the Petition where findings of the Lower Court are discussed.

On page 14 it is said, with respect to the "factual inquiry" of the "differences between the prior art and the claims at issue," that the Trial Court's Finding No. 27 fails

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(Continued from preceding page)

"Inquiries of this kind are often attended with difficulty; but if special attention is given to such portions of a given device as really does the work, so as not to give undue importance to other parts of the same which are only used as a convenient mode of constructing the entire device, the difficulty attending the investigation will be greatly diminished, if not entirely overcome. *Cahoon v. Ring*, 1 Cliff. 620.

"Authorities concur that the substantial equivalent of a thing, in the sense of the patent law, is the same as the thing itself; so that if two devices do the same work in substantially the same way, and accomplish substantially the same result, they are the same, even though they differ in name, form or shape. Curtis, Patents (4th ed.), sect. 310."

to set forth *all* the structural differences *as well as any of the differences in function, operation and results* between the Porteous and Skega patents. On page 15 it was said, with respect to the same "factual inquiry" as applied to the Straus, Overman and Skega patents, that the Court's Finding No. 28 did not consider the differences in structure, *function and purposes* of those patents. Respondent did not, and cannot, deny any of those charges.

Thus, the courts below did not follow, in fact clearly violated, that 100 year old rule of this Court.

It seems clear that the instructions set out in the *Graham* and *Black Rock* cases have been understood by the lower courts, generally, to mean that they should consider *only* differences in structure in deciding patent validity. Both the *Graham* and *Black Rock* cases stressed strict observance of "three basic factual inquiries," one of which was that "the differences between the prior art and the *claims at issue*[2] are to be ascertained." Since the Skega patent is for apparatus only structure was, or could be set forth in the patent claims. Since neither mode of operation nor results are included or includable in apparatus claims, the expression "claims at issue" actually means that only structure is to be considered. Since this Court did not mention mode of operation and results in that factual inquiry in either of those cases, it might well be assumed that this Court intended that neither of those factors was to be considered in determining the validity of an apparatus patent. However, as was stated in the *Machine Co.* and *Bates* cases, validity is to be determined on the basis of the three factors of structure, mode of operation and results.

Apparently the courts in the numerous lower court decisions handed down subsequent to the *Graham* and

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[2] Emphasis added.

Black Rock cases seem to have made that very assumption. Many of those numerous decisions have been examined and each of the examined decisions has considered structure but none has mentioned either the *Machine Co.* or the *Bates* case in connection with the issue of validity.

V.

Respondent now argues that the Court of Appeals below did not apply the "clearly erroneous" rule of Rule 52(a) F.R.C.P. in reviewing the question of obviousness under 35 U.S.C. 103 although the Court of Appeals specifically cited the rule in connection with its review on the point A 4. See Reply Brief p. 15.

Respondent seems to forget that it argued before the Court of Appeals that the Court's scope of review was limited by Rule 52(a) and the resulting error by that Court on the point arose from its accepting respondent's argument. Thus, Respondent is indeed "hoist on its own petard."

This important and fundamental error of law should be corrected by this Court.

VI.

Respondent dealt extensively with the merits of the case in its Reply Brief. Even so, respondent studiously avoided commenting on the crux of the decision below,

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The Court of Appeals also stated (A3): "In Lawler, No. 1,315,025 [Appendix 4], and Read, No. 1,986,530 [Appendix 5], virtually the identical combinations were present, however, the analogues of the Svensson lifting means and lining plates were made entirely of metal rather than rubber." Of course, none of the problems involved in the patent in suit are present until one gets away from metal and tries to achieve the desired result with rubber. Reference to Lawler and Read, therefore, only indicates complete lack of comprehension of the issues in the case.

viz., that the combination of the rubber lined ball mill art of Porteous with the solid rubber tire clamping out of Straus and Overman was obvious within 35 U.S.C. 103 despite the fact that respondent, the B. F. Goodrich Co., on of the world's greatest experts in *both* arts, worked on the problem of rubber lined ball mills for forty years and never was able to see this "obvious" combination until after the Skega invention was publicized in the United States whereupon it was promptly copied by respondent.

In the Petition we stated that the decision below was in conflict with *United States v. Adams*, 383 U.S. 39, which we believe controls the instant case. Respondent, at Brief p. 19, distinguished *Adams* from the instant case on the not entirely convincing ground that in one case the plaintiff won and in the other the defendant won. We respectfully request the Court to review *Adams* in connection with the instant Petition.

VII.

CONCLUSION.

This Court took a long step forward toward bringing about "uniformity and definiteness" in patent decisions when it decided the *Graham* case in 1966. However, that decision seems to have created new uncertainty and indefiniteness in that the lower courts were not instructed, even inferentially, to consider differences in the mode of operation and results between the devices of the prior art and of the patent in suit. That uncertainty and indefiniteness was increased by the repetition in the *Black Rock* case of the instructions in the *Graham* case.

As a result, it is not clear whether the rule of *Machine Co.* and *Bates* is still in force, has been overruled or has been abolished. Counsel cannot advise clients on the question of whether the factors of mode of operation and re-

sults are to be considered in determining patent validity. Inventors and patent owners cannot decide that question for themselves. The courts are not advised by the *Graham* and *Black Rock* decisions as to whether the rule of *Machine Co.* and *Bates* is to be observed or ignored.

This Court can take a further step which would remove that uncertainty and indefiniteness by giving instructions to the lower courts to follow the rule of the *Machine Co.* and *Bates* cases in ascertaining the differences between the prior art and the claims at issue. That step can be taken in this case if the present Petition is granted. If the Petition is denied, the present confusion and indefiniteness will continue.

If the rule of *Machine Co.* and *Bates* which has stabilized part of the patent law for so many years has been overruled or abolished, that rule should be given public burial. If that rule still lives, the courts and the public should be informed of that fact.

Respectfully submitted,

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PETITION FOR REHEARING OF THE PETITION FOR WRIT OF CERTIORARI IN THIS CASE WHICH WAS DENIED ON OCTOBER 12, 1970.

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PETITION FOR REHEARING OF THE PETITION FOR WRIT OF CERTIORARI IN THIS CASE WHICH WAS DENIED ON OCTOBER 12, 1970.

Petitioners request a rehearing of their Petition for Writ of Certiorari which was denied by this Court on October 12, 1970.

The grounds for this request are the questions and reasons set forth in the said petition and the following additional reasons, all relating to the meaning and construction of the Statute, 35 U.S.C. 103, which was the basis for the petition.

Greater non-uniformity and diversity of decisions regarding that Section 103 have occurred since February 21, 1966, than had occurred in the previous 14 years, i.e., back to January 1, 1952, when that statute was enacted. The

decisions of the appellate courts had been so non-uniform and diverse during that 14-year period that this Court felt impelled to construe and state the requirements for decisions under that section.

This Court granted petitions for certiorari in three cases decided by the Court of Appeals for the Eight Circuit, i.e., *Graham v. John Deere; Calmar, Inc. v. Cook Chemical Company* and *Colgate-Palmolive v. Cook Chemical Company;* and one case from the Court of Claims, *U. S. v. Adams.* These several cases were decided on February 21, 1966, and are reported in 383 U.S. 1-52.

Three years later, this Court repeated those instructions in the case of *Anderson's-Black Rock, Inc. v. Pavement Salvage Co.*, 396 U.S. 57 (Dec. 8, 1969). In both the *Graham* and *Black Rock* cases, this Court expressed the hope that its instructions, set forth in those decisions, would result in uniformity and certainty of patent decisions. However, that hope has not been realized.

The stream of patent decisions split into two oppositely divergent branches after passing the "three basic factual inquiries" of the *Graham* case. The rock which split that stream was the issue of when the "secondary considerations" may be used.

There are two lines of decisions which illustrate the divergent views of the courts on this issue. One line of cases holds that the secondary considerations may be used in all cases, even where the question of non-obviousness is close and in cases where the combination of old elements is present. The other line of cases holds that the secondary considerations may not be used under either of those just stated conditions, nor where obviousness is clear, or the patent teaches nothing of significance, and no matter how useful the patented device has been, or how long and by how many it was sought.

The first line of decisions is illustrated by the following cases:

CA 1 *Columbia Broadcasting System v. Sylvania Electric Products, Inc.*, 415 F.2d 719 (cert. denied 396 U.S. 1061).

CA 5 *Zero Manufacturing Co. v. Mississippi Milk Producers Association*, 358 F.2d 853.

CA 5 *National Athletic Supply Corp. v. Muscle-Matic, Inc.*, 164 USPQ 330, affirming 164 USPQ 10.

Ct. Cls. *Palmer v. United States*, 165 USPQ 88, affirming 163 USPQ 250.

CCPA *Application of Roy A. Grout*, 377 F.2d 1019.

CCPA *Application of VanWonderham*, 378 F.2d 981.

CA 7 *Mercantile National Bank of Chicago v. Quest, Inc.*, 166 USPQ 513 (Aug. 13, 1970).

CA D.C. *Higley v. Bremmer*, 387 F.2d 855.

The second line of decisions is illustrated by the following cases:

CA 2 *Continental Can Company v. Old Dominion Box Company*, 393 F.2d 321.

CA 3 *Continental Can Company v. Crown Cork Company, Inc.*, 163 USPQ 1 (cert. denied 90 SCR 916).

CA 6 *Kaiser Industries Corporation v. McLouth Steel Corporation*, 400 F.2d 36 (cert. denied 393 U.S. 1119).

CA 6 *Eisele v. St. Amour*, 423 F.2d 135.

CA 6 *The present case*, 420 F.2d 1358 (cert. denied Oct. 12, 1970).

CA 8 *National Connector Corporation v. Malco Manufacturing Company*, 392 F.2d 766.

CA 9 *Spring Crest Company v. American Beauty Pleat, Inc.*, 420 F.2d 950.

CA 9 *Carborundum Company v. Wilbanks, Inc.*, 420 F.2d 43.

Because of the divergent views of the several courts as indicated in the foregoing lines of decisions, it is virtually a foregone conclusion that if any of the patents sustained in the first line of decisions were submitted to the courts which decided the cases in the second line of decisions, such patents would not have been sustained.

By the same token, if any of the patents held invalid in the second line of decisions were to be submitted to the courts involved in the first line of decisions, it is also extremely probable that those patents would be sustained.

The confusion and uncertainty resulting from the foregoing diversity of decisions was not reduced and may have been increased by the failure of this Court to grant petitions for certiorari from the two lines of decisions, such as *Columbia v. Sylvania* in the first line and *Kaiser v. McLouth* and the present case in the second line.

In view of the utter confusion which exists in the patent law because of the conflicts and diversities of decisions now existing, it would seem to be high time for this Court to speak out and settle the conflicts so that the decisions in patent cases may attain the object of uniformity and certainty which was expressed in the *Graham* case.

The statute, Section 103, did not refer to "factual inquiries" or "secondary considerations." While the *Graham* case mentioned both those inquiries and considerations, it placed no restriction on the use of the considerations except that they were to be directed to the issue of non-obviousness or obviousness.

There is no apparently good reason why the secondary considerations should not be used in every case. They are susceptible of proof, and fact proof is required to support a conclusion of obviousness which is a matter of law, as was stated in the *Graham* case. Indeed, in the *Adams* case, secondary considerations were used in sustaining the patent.

There is no apparently good reason why fact proof of secondary considerations may not be used in a "close case" for that is where it may be most needed.

There is no apparently good reason why fact proof of secondary considerations should be brushed aside and a decision of obviousness made without any proof support.

Petitioners respectfully request that this petition for rehearing be granted.

Respectfully submitted,

B. D. WATTS,
Attorney for Petitioners.

Cleveland, Ohio
Nov. 6, 1970.

Certificate.

I hereby certify that the foregoing petition is brought under Rule 52(2) of the Rules of the Supreme Court of the United States; that the said petition is presented in good faith and not for delay, that the petition is restricted to the grounds originally presented and that the additional grounds above noted are substantial and were available to petitioners although not previously presented.

I further certify that this petition has been served on Counsel for the Respondent.

B. D. WATTS,
Attorney for Petitioners.

Nov. 6, 1970.